

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: James A. Michael, et al.)	
)	
Serial No.: 09/384,650)	Art Unit 3651
)	
Filed: August 27, 1999)	Patent Examiner:
)	Michael E. Butler
Title: Method For Dispensing Medical Items)	

Board of Patent Appeals and Interferences
Commissioner of Patents and Trademarks
Washington, D.C. 20231

BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192

Sir:

The Appellants hereby submit their Brief pursuant to 37 C.F.R. § 1.192, in triplicate,
concerning the above-referenced Application.

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REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is
Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 40-67 are pending in the Application.

Claims 40-60 and 63-67 were rejected pursuant to 35 U.S.C. § 112, second paragraph.

Claims 40, 42-43, 49-51, 60-61, and 63-66 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Blechle et al. ("Blechle"). There is a question as to whether the reference to Blechle et al. is of record, which is discussed in more detail below.

Claims 40, 42-43, 46-47, 63, and 66 were rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by Higham et al. '366 ("Higham"). The reference to Higham et al. '366 is viewed by Appellants as Higham et al. 5,745,366.

Claims 40, 42-43, and 46-47 were rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by Kraft et al. 5,502,944 ("Kraft"). The reference to Kraft is viewed by Appellants as Kraft et al. 5,502,944.

Claims 65-66 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Williams '294 ("Williams"). The reference to Williams '294 is viewed by Appellants as Williams 5,460,294.

Claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham.

Claims 40-44, 46-49, 52-60, 62-64, and 66-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Kraft.

Claims 40-49, 52-60, and 62-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft in view of Pitel et al. 4,023,704 ("Pitel"). The reference to Pitel is viewed by Appellants as Pitel et al. 4,023,704.

Claims 40, 43, 45, 52-53, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitel.

Claims 40, 42-44, 46, 48-51, 55, and 59-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Blechle in view of Kraft.

Claims 40-43, 46-47, 49-54, and 57-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Blechle.

Claims 63 and 65-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Gardner et al. '294 ("Gardner '294"). There is a question as to whether the reference to Gardner '294 is of record, which is discussed in more detail below.

Claims 63-64 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Halverson. There is a question as to whether the reference to Halverson is of record, which is discussed in more detail below.

Claims 63-67 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Williams in view of Higham.

These rejections were the only rejections present in the Office Action ("Action") dated December 4, 2000. Appellants appeal each claim rejection, inclusive.

Comments/Request

Appellants apologize to the Board for any undue burden placed before them. MPEP 706.02 clearly indicates that prior art rejections are to be strictly confined to using the best or most pertinent references (i.e., the primary rejection). MPEP 706.02 also allows for a backup rejection using the (second) best available other art rejection in certain situations. However, MPEP 706.02 makes clear that cumulative rejections are not permitted.

Yet the Action dated December 4, 2000 clearly contains cumulative rejections. For example, claim 40 was rejected nine (9) different times using different art rejections, and claim 63 was rejected ten (10) different times using different art rejections. The present application only contains 28 claims. However, the Office applied 13 different art rejections involving 7 different references for a total of 153 individual claim rejections. On average, each claim was rejected on art over five (153/28) times. The Action gives the appearance of trying to force Appellants into submission based solely on the unnecessary volume entailing the cumulative rejections. Appellants respectfully submit that the cumulative rejections are merely reflective of the baseless character of all the rejections in the Office Action, as shown in more detail later.

Nevertheless, to simplify the issues present herein, the Office is hereby requested (in accordance with the Office's own examining procedures) to determine the primary (best) rejection for each individual claim so that the Board may concentrate their efforts on said

rejections. It follows that if the best rejection is found lacking by the Board, then the other (weaker) rejections to that claim would also (by inference) be considered as lacking. Appellants do not relinquish any rights in making this request.

STATUS OF AMENDMENTS

A final rejection was made December 4, 2000. No amendments to the claims were requested to be admitted after the final rejection.

It is noted that the final rejection was the fourth Office action in the present application. The final rejection followed a restriction requirement action (later withdrawn) and two non-final rejection actions. Thus, claims have also been thrice rejected.

SUMMARY OF INVENTION

Overview of the Invention

An exemplary embodiment of the invention is directed to a method performed with a medical item dispenser (10). The dispenser includes an enclosure (12), a door (16) in operative connection with the enclosure, and a path (54) extending in the enclosure (e.g., Figures 2 and 3). The path (54) may be in connection with a delivery area (20), whereby dispensed medical items are accessible to a user in the delivery area. A dispenser module (24, 28, 30) may be movably mounted to be supported with the enclosure. The dispenser module may include a holder (e.g., 124; Figure 12) for medical items, and a dispenser mechanism (e.g., 76; Figure 5). The dispenser

mechanism is selectively operable to dispense medical items from the holder at a dispense location (50, 52) positioned adjacent the path (54) (Figure 2). When the door (16) is open (Figure 3), the holder is able to be moved outside of the enclosure (12). The mounted dispenser module (e.g., 28; Figures 3 and 4) is movable to position the holder outside the enclosure. A medical item may be added or removed from the holder while the holder extends outside the enclosure. The dispenser module may be retracted to return the holder within the enclosure, and the door (16) may be closed.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

- 1). Whether Appellants' claims 40-60 and 63-67 are unpatentable under 35 U.S.C. § 112, second paragraph.
- 2). Whether Appellants' claims 40, 42-43, 49-51, 60-61, and 63-66 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Blechle.
- 3). Whether Appellants' claims 40, 42-43, 46-47, 63, and 66 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Higham.
- 4). Whether Appellants' claims 40, 42-43, and 46-47 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Kraft.
- 5). Whether Appellants' claims 65-66 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Williams.

- 6). Whether Appellants' claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66-67 are unpatentable under 35 U.S.C. § 103(a) over Higham.
- 7). Whether Appellants' claims 40-44, 46-49, 52-60, 62-64, and 66-67 are unpatentable under 35 U.S.C. § 103(a) over Higham in view of Kraft.
- 8). Whether Appellants' claims 40-49, 52-60, and 62-67 are unpatentable under 35 U.S.C. § 103(a) over Kraft in view of Pitel.
- 9). Whether Appellants' claims 40, 43, 45, 52-53, and 56 are unpatentable under 35 U.S.C. § 103(a) over Pitel.
- 10). Whether Appellants' claims 40, 42-44, 46, 48-51, 55, and 59-67 are unpatentable under 35 U.S.C. § 103(a) over Blechle in view of Kraft.
- 11). Whether Appellants' claims 40-43, 46-47, 49-54, and 57-67 are unpatentable under 35 U.S.C. § 103(a) over Higham in view of Blechle.
- 12). Whether Appellants' claims 63 and 65-67 are unpatentable under 35 U.S.C. § 103(a) over Higham in view of Gardner.
- 13). Whether Appellants' claims 63-64 and 66 are unpatentable under 35 U.S.C. § 103(a) over Higham in view of Halverson.
- 14). Whether Appellants' claims 63-67 are unpatentable under 35 U.S.C. § 103(a) over Williams in view of Higham.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Each of Appellant's claims 40-67 recite at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

Every claim recites additional features of the invention which patentably distinguishes the claim over every other pending claim.

The pending claims include four independent claims (claims 40, 52, 53, and 61). Claims 41-51 and 63-67 depend from claim 40. Claims 54-60 depend from claim 53. Claim 62 depends from claim 61.

The claims involved in this appeal are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102(b) requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102(b) requires in a single prior art disclosure, each and every element of the claimed invention in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish prima facie obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The Action Is Defective

Appellants submit that the Action does not comply with the rules of the Patent Office. Nor has the Office properly conducted a *Graham v. John Deere Co.* analysis. Specifically the Action fails to provide Appellants with an element by element analysis of each claim, and an indication of where the elements or steps in each claim are found in the applied art. On numerous occasions the Action is silent as to which elements, if any, in the applied references

constitute the recited features and relationships. Further, the Action fails to identify a source of any teaching, suggestion, or motivation in the prior art to produce the invention as claimed by Appellants. MPEP §706.02(j). Rather the Action consists of citations to large sections of the applied references and parenthetical indications of Appellants' claims which encompass the alleged features. In this way, the Action appears to be an attempt at impermissible reconstruction of Appellants' invention based on Appellants' own teachings. Such analysis is impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992).

Furthermore, the Action does not state in any way that is reasonably understandable by Appellants, where the specific features recited in Appellants' claims are allegedly found in the relied upon art. Not one rejection based on prior art has specifically labeled the claimed features allegedly found in the applied reference(s). Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art references to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish anticipation or a prima facie case of obviousness against any of the claims and the rejections should be withdrawn.

Because the Action fails to directly apply the references to the claims, Appellants have been unduly burdened by having to speculate as to possible rationales for the rejections. The Patent Office bears the burden of citing and applying prior art in a clear manner to support any rejections made. The failure by the Office to indicate the recited claim features in the applied references constitutes Agency action under the Administrative Procedures Act acknowledging

that the references do not meet the recited claim features. Thus, the Action's failure to clearly identify on the record where the recited features are allegedly found in the applied references has been taken as an admission by the Office that the applied references do not disclose nor suggest the recited features. It follows that the recited invention would not have been anticipated nor obvious.

Nevertheless, Appellants have reviewed the references cited and have determined that for the reasons stated herein that the cited references, taken individually or as a whole, clearly do not teach nor suggest the inventions recited in Appellants' claims. Therefore, the claims directed to the present invention would not have been obvious to one having ordinary skill in the art.

The References

The Blechle et al. Reference

There is no Blechle et al. reference of record. There is a Blechl of record.

The Blechl (5,377,864) Reference

The reference to Blechl is directed to a drug dispenser device (10). As shown in Figure 1, the dispenser device includes a drawer (28) which provides access to the dispensed medicines. When a user designates a type and quantity of desired medications into the input unit (248) of the control device (300), the medications drop from their cartridges (90) into the drawer (28). The input unit may include a user interface screen (30) having touch sensitive features in

communication with a microprocessing means (26). The top of the device (10) is provided with a medication access door (40) permitting a designated user to stock the device.

As shown in Figure 2, the device (10) includes a medication storage area. A printed circuit board (50) has apertures (52, 54) allowing free fall of drug containers to the drawer (28). The board (50) includes female electrical connectors (56). Figures 3, 4, and 11 show a dispenser (60) made to be inserted into the medication storage area. Offset from the bottom of the dispenser (60) is a support lip (76) which rests against the printed circuit board (50) to support the dispenser (60). Extending downward from the support lip (76) is a male electrical connector (78) adapted to connect with a female electrical connector (56). A solenoid (68) is provided on the exterior of the dispenser housing (62). The solenoid (68) includes a piston (70) which is operatively connected to rotating linkage (72) which is contained on a pivot rod (74). The pivot rod (74) is secured to an arm (82) having a stepped portion (84). Actuation of the solenoid (68) causes rotation of pivot rod (74). Note Figures 10, 15, 17, and 18.

Figures 5-9 show a cartridge (90) for insertion into the dispenser (60). The cartridge (90) is sized to slide into the interior space (64) of the dispenser (60). Stacked medication containers (108) are contained in the interior storage space (102) of the cartridge (90). A retaining member (110) prevents the medication containers (108) from falling out the open bottom (100) of the cartridge (90).

Upon insertion of the cartridge (90) into the dispenser (60), the user removes the retaining member (110) allowing free fall of the medication containers (108) to a dispensing platform (86) of the dispenser (60). The dispensing platform (86) has an aperture (88). Upon actuation of the

solenoid (68), the stepped portion (84) urges the medication container (108) resting on the dispensing platform (86) out the aperture (88) where gravity induces it to falls to the drawer (28).

The Higham Reference

The reference to Higham is directed to a dispenser unit (28). The dispenser unit includes an enclosure with a plurality of drawers (32) slidably disposed with a frame (34). The drawers are provided with receptacles (36) for holding items. A row of buttons (30) is common to the drawers. As shown in Figure 2 the six buttons (30) correspond to the six receptacles (36) in each drawer (32). Each drawer has a sensor (40) for sensing when the drawer has been pulled out from the frame (34). The sensors (40) and buttons (30) are connected to a processor. When a particular drawer (44) is opened, the associated sensor (40) sends a signal to the processor indicating access to that drawer (32). The processor then sends a signal to set the buttons (30) to correspond to the receptacles (36) of that particular withdrawn drawer (32). An item is manually placed into or removed from a particular receptacle (36) of the withdrawn drawer (32). The button (30) having the same identification symbol (38) as the accessed receptacle (36) is manually touched to record the action in the processor. Inventory is maintained by using the associated buttons (30).

The Kraft Reference

The reference to Kraft is directed to a medication dispenser system. Each medication dispenser (12) stores medications (134) in specialized containers (90, 130). The system uses

robotics (40) for manipulating a selected container (90, 130) to transfer medication units from the container directly to a package (314). In operation, the bulk medication container (130) is manipulated by the robotics (40) to place a single medication unit in a discharge holding area (152) of the container. A helical ridge (136) acts as a ramp for pills (134) in the container (130). The container is rotated to drop the medication unit into an opening (334) in a pocket (314) of a packaging system (38) where the unit is sealingly packaged. Particularly note Figures 6-9 and 26. A computer (46) of the system controller (34) requires identification from a user in order to access the dispenser (12) (col. 5, lines 8-14).

The Pitel Reference

The reference to Pitel is directed to a helical feed merchandising machine for dispensing bagged snacks. The machine (10) includes a cabinet (12) having sides (14, 16) and a door (20). Each delivery tray or shelf (36, 38, 40, 42) includes plural delivery units (44). Each of the units (44) includes a pair of helixes (106, 108). Each bagged snack is supported between a pair of helixes. The pair of helixes (106, 108) are driven to advance the bagged snack over the edge of a shelf (56) (col. 7, lines 17-20). Each tray includes a base (56), back panel (58), and sides (60, 62) with mounted rollers (64, 66, 68, 70). Each cabinet side (14, 16) has rails (50, 52) for receiving the rollers. The tray (36) is mounted for rolling movement inward and outward of the cabinet. When the shelf has been rolled outward, and the rear rollers (70) are aligned with slots (78) in the upper rails (50), then the tray can be pivoted downward until the back panel (58) engages stop pins (80) (Figure 3). In this position the tray can be loaded.

The Williams Reference

The reference to Williams is directed to a single dose dispenser subassembly. An endless belt (107) has attached thereto open magazine cups (109) that each contain a single dose. A magazine cup is moved adjacent to a door (63). A user is required to manually open the door (63) to dispense the single dose (col. 7, lines 53-55).

The Gardner et al. '294 Reference

There is no Gardner et al. '294 reference of record in the Application. There is a Gardner '951 and a Gardner '306 of record.

The Halverson Reference

There is no Halverson reference of record in the Application. There is a Halvorson of record.

(ii) 35 U.S.C. § 112, Second Paragraph

Claims 40-60 and 63-67 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. These rejections are respectfully traversed.

The Action indicates that using “or” creates vague and indefinite claims. The Action further indicates that these claims have been examined presuming the use of a Boolean “OR.”

The Appellants respectfully disagree that the use of the term “or” renders the claims indefinite. For example, claim 40 clearly recites either “adding” at least one medical item or

“removing” at least one medical item. Claim 40 is neither vague nor indefinite. Likewise, the other claims with the term “or” are not vague nor indefinite. The Action’s presumption of “or” was not necessary since “or” is already clearly recited in the claim. Nevertheless, the Action’s own presumption of “or” is evidence that using “or” does not render the claims vague or indefinite. Further evidence may be found in the cited U.S. Patent 5,745,366 (Higham), for example at claim 1, which used the acceptable term “or” on several occasions. Additional evidence may be found in the cited U.S. Patent 5,805,456 (Higham et al.), for example at claim 51, which also used the acceptable term “or.” One of ordinary skill in the art of patent prosecution would recognize that “or” in the claims does not render the claims indefinite.

The Action’s suggestion to restructure the “elements” if coverage encompassing alternative “elements” is sought is unclear, because the claims are method claims.

Nevertheless, to expedite prosecution, the Appellants indicated that they would be willing to amend the current claim language of “adding or removing at least one medical item from the holder” to the proposed language of “transferring at least one medical item from or to the holder.”

The Action at page 16, first paragraph, agreed that the proposed language would be “an acceptable solution” in overcoming the alleged 35 U.S.C. § 112, second paragraph, rejections. Hence, the current 35 U.S.C. § 112, second paragraph, rejections should be viewed as moot in light of both parties reached agreement to later amend the claims as indicated (if necessary). (It should be noted that the language indicated as “acceptable” in the Action also contains “or”).

Regarding claim 67 the Action alleges that the language “generally cylindrical liquid” is vague and indefinite. The Appellants disagree. First, the claim 67 language is not directed to “generally cylindrical liquid”, but to “a generally cylindrical liquid holding container.” Said claim language is neither vague nor indefinite, but has well known meaning. The Action’s misuse of the actual claim language is not appreciated. Nevertheless, the Action’s misuse of the actual claim language is reflective of all the rejections in the Office Action.

It is respectfully submitted that the 35 U.S.C. § 112, second paragraph, rejections are not appropriate and withdrawal thereof is requested.

(iii) 35 U.S.C. § 102

Appellants’ arguments against the prior art rejections are based on the Office’s interpretation of the reference as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the reference by the Office would constitute a new grounds of rejection.

The Pending Claims Are Not Anticipated By Blechl

In the Action claims 40, 42-43, 49-51, 60-61, and 63-66 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Blechl. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that the Blechl reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claims patentably distinguish over the Blechl reference.

Furthermore, the Action has not stated where the specific features of Appellants' claims are allegedly found in the Blechl reference. The Office was respectfully asked to clearly state on the record which specific (numbered) features in the Blechl reference directly corresponded to the claimed dispenser, enclosure, dispenser module, holder, dispenser mechanism, and medical item. The Action's failure (refusal) to specifically indicate the presence of the recited claim features in the Blechl reference constitutes Agency Action under the Administrative Procedures Act admitting that the reference does not meet the recited claim features. Allowance of the claims is respectfully requested as the Action is legally insufficient.

Claim 40

Claim 40 is an independent claim which is specifically directed to a method performed in connection with a dispenser. The claim specifically recites that the dispenser module "includes a holder enabling holding of medical items" and "a dispenser mechanism, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder." Furthermore, the claim specifically recites "moving the dispenser module, while mounted, from a first position, wherein the dispenser module is within the enclosure, to a second position, wherein the holder extends outside the enclosure."

Blechl does not disclose a dispenser module including a dispenser mechanism in the manner recited. Blechl also does not disclose a "dispenser module movably mounted in

supporting connection with an enclosure.” Blechl does not disclose moving a “mounted” dispenser module including a “holder” and “a dispenser mechanism” in the manner recited.

Blechl shows a cartridge (90) (Figures 5-6 and 10-11) for insertion into a dispenser (60). Stacked medication containers (108) are contained in the interior storage space (102) of the cartridge (90) (Figures 6 and 10).

Blechl does not disclose a dispenser module being mounted in the manner recited. Blechl does not disclose a “mounted” dispenser module including a “holder” and “a dispenser mechanism” in the manner recited. Blechl does not disclose moving a dispenser module, while mounted, including a “holder” and “a dispenser mechanism” in the manner recited.

Blechl states that element (60) is the dispenser. However, the Action is silent as to what feature, if any, in Blechl is asserted to correspond to the recited dispenser module. It remains unclear as to what element in Blechl is asserted to constitute the recited dispenser module. The Action alleges that Blechl discloses moving a dispenser module from a position within the enclosure to a position outside the enclosure (col. 3, line 52 to col. 4, line 2). The referenced lines in Blechl refer to a door (28) (Figure 1). However, as the rejection is best understood, it is unclear whether the Action alleges that Blechl’s door (28) constitutes the dispenser module.

Nevertheless, Blechl’s drawer (28) cannot constitute the recited dispenser module because it does not include a “dispenser mechanism” as recited.

Blechl’s cartridge (90) cannot constitute the recited dispenser module because it does not include a “dispenser mechanism” in the manner recited. Furthermore, the cartridge (90) is not “movably mounted in supporting connection with an enclosure.” Additionally, the cartridge (90)

does not include a “holder” and “a dispenser mechanism.” Additionally, the cartridge (90) is not “selectively operable to dispense medical items from the holder.” Additionally, the cartridge (90) is not moved while “mounted in supporting connection with an enclosure.” Additionally, the cartridge (90) does not include a “holder” and “a dispenser mechanism” while being moved and while being “mounted in supporting connection with an enclosure.” Additionally, the cartridge (90) is not capable of being moved, “while mounted” in supporting connection with an enclosure, from a first position “within the enclosure” to a second position, wherein the holder “extends outside the enclosure.”

Blechl’s dispenser (60) cannot constitute the recited dispenser module because it does not include a “holder enabling holding of medical items” and “a dispenser mechanism” in the manner recited. Additionally, the dispenser (60) is not capable of being moved, “while mounted” in supporting connection with an enclosure, from a first position “within the enclosure” to a second position, wherein the holder “extends outside the enclosure” in the manner recited. Furthermore, Blechl’s stated dispenser (60) is limited to being a dispenser, not a dispenser module, as previously discussed.

Blechl does not disclose a dispenser module being mounted, in the manner recited. Blechl does not disclose a dispenser module capable of moving while being mounted, in the manner recited. Blechl does not disclose a “dispenser” in the manner recited.

Blechl does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejection. Blechl clearly does not disclose the recited method, and Appellants’ claim patentably distinguishes over the Blechl

reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection is not appropriate and that claim 40 patentably distinguishes over Blechl. It follows that the claims which depend from claim 40 are likewise allowable.

**The Dependent Claims Recite Features Which Further
Patentably Distinguish Over Blechl**

There are also a number of features that are expressly recited in claims that depend from claim 40 that further distinguish the preferred embodiment of the present invention over the cited art.

Blechl does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required for a valid rejection. Blechl does not disclose the recited method, and Appellants' claims patentably distinguish over the Blechl reference.

Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejections are not appropriate for the further reasons discussed below.

Claim 42

Claim 42 depends from claim 40 and recites further features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “manually adding or removing at least one medical item from the holder.”

Blechl does not disclose “manually adding or removing at least one medical item from the holder” in the manner recited. Thus, it is respectfully submitted that the claim is further allowable on this basis.

Claim 43

Claim 43 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that a “door is movable between a closed position wherein the door closes the opening, and an open position wherein the door is disposed away from the opening.” The claim further recites that “when the door is in the open position the dispenser module is movable to the second position.” The Action is silent as to what feature, if any, in Blechl is asserted to correspond to the recited door. It remains unclear as to what element in Blechl constitutes the recited door. Blechl does not disclose the relationship of a “door” and the movement of the “dispenser module” as specifically recited. Thus, it is respectfully submitted that claim 43 is further allowable.

Claim 49

Claim 49 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “a further dispenser module in the interior area” and “dispensing a first medical item including a supporting card from the dispenser module” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further dispenser module.” The Action is silent as to what features, if any, in Blechl are asserted to correspond to the recited supporting card and generally cylindrical liquid holding container. It remains unclear as to what elements in Blechl constitute the recited supporting card and the generally cylindrical liquid holding container. Blechl does not disclose “a further dispenser module” or dispensing “a supporting card” or

“generally cylindrical liquid holding container” in the manner recited. Thus, it is respectfully submitted that claim 49 is further allowable on this basis.

Claim 50

Claim 50 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “medical items are biased to move by gravitational force” and “providing a follower in engagement with the stack, wherein in the first position the follower provides additional biasing force on the stack.” Blechl does not disclose medical items “biased to move by gravitational force” and a “follower in engagement with the stack” in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

The Action alleges that Blechl discloses engaging a follower in engagement with the stack, at col 7, line 46 to col. 8, line 13. However, the referenced col 7, line 46 to col. 8, line 13, appears directed to the medication containers (108) of Figure 10. The Action is silent as to what feature, if any, in Blechl is asserted to correspond to the recited follower. It remains unclear as to what element in Blechl constitutes the recited follower. It is respectfully asserted that Blechl does not disclose a follower that “provides additional biasing force on the stack.” It follows that Blechl does not disclose “providing a follower in engagement with the stack, wherein in the first position the follower provides additional biasing force on the stack” in the manner recited. Thus, it is respectfully submitted that claim 50 is further allowable on this basis.

Claim 51

Claim 51 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “medical items are biased to move by gravitational force” and a “movably positionable guide extending adjacent the stack” and a “generally cylindrical rotatably movable follower, including at least one annular groove, in operative engagement with the stack.” Blechl does not disclose medical items “biased to move by gravitational force” and a “movably positionable guide” and a “generally cylindrical rotatably movable follower” in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

The Action alleges that Blechl discloses engaging a follower in engagement with the stack, at col 7, line 46 to col. 8, line 13. However, as previously discussed, the referenced col 7, line 46 to col. 8, line 13, appears directed to the medication containers (108) of Figure 10. The Action is silent as to what feature, if any, in Blechl is asserted to correspond to the recited “follower.” It remains unclear as to what element in Blechl constitutes the recited follower. In reality Blechl does not disclose a follower that “provides additional biasing force on the stack.” It follows that Blechl does not disclose “providing a follower in engagement with the stack, wherein in the first position the follower provides additional biasing force on the stack” in the manner recited. Thus, it is respectfully submitted that claim 51 is further allowable on this basis.

Claim 60

Claim 60 depends from claim 53. In the Action, claim 53 was not asserted to be anticipated by Blechl. It follows that claim 60, which includes the features and relationships of claim 53, is not anticipated by Blechl.

Claim 60 further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “a further dispenser module in the interior area” and “dispensing a first medical item including a supporting card from the dispenser module” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further dispenser module.” The Action is silent as to what features, if any, in Blechl are asserted to correspond to the recited supporting card and generally cylindrical liquid holding container. It remains unclear as to what elements in Blechl are asserted to constitute the recited supporting card and the generally cylindrical liquid holding container. Blechl does not disclose “a further dispenser module” or dispensing “a supporting card” or “generally cylindrical liquid holding container” as recited. Thus, it is respectfully submitted that claim 60 is further allowable on this basis.

Claim 61

Claim 61 is an independent method claim. The claim specifically recites dispenser modules “in movably supporting connection with the enclosure” through guide arrangements. The guide arrangements are adapted to guide the dispenser modules “during movement.” Blechl does not disclose a “guide arrangement” capable of supporting and guiding a dispenser module

during dispenser module movement, as recited. Further, Blechl does not disclose a dispenser module movable while in supporting connection with the enclosure.

The Action alleges that Blechl at col 2, lines 13-31, discloses “providing an enclosure with a delivery area accessible from outside the enclosure providing a first dispenser module within the enclosure, wherein dispenser module includes a plurality of medical items and is selectively operative to dispense first medical items therefrom; providing a second dispenser module in the enclosure in supporting connection with the enclosure through a second support, wherein second and first supports are interchangeably engageable to support the first or second dispenser modules, and second dispenser includes a plurality of second medical items selectively operative to dispense the second medical items therefrom, wherein second medical items are dispensed from the second dispenser in the enclosure.” However, the referenced col 2, lines 13-31, is directed to a brief description of the Blechl’s invention, and does not mention any of the alleged recited features. The Action is silent as to what feature, if any, in Blechl is asserted to correspond to the recited enclosure; delivery area; first dispenser module; first guide arrangement; first medical items; second dispenser module; second guide arrangement; and second medical items. It remains unclear as to what elements in Blechl are asserted to correspond to the recited features.

Blechl clearly does not disclose or suggest dispenser modules “in movably supporting connection with the enclosure” through guide arrangements, wherein the guide arrangements are adapted to guide the dispenser modules “during movement. Blechl further does not disclose a

dispenser module movable while in supporting connection with the enclosure in the manner recited. It is respectfully submitted that claim 61 is allowable for at least these reasons.

Blechl does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejection. Blechl does not disclose the recited method, and Appellants' claim patentably distinguishes over the Blechl reference. It is respectfully submitted that the 35 U.S.C. § 102(b) rejection is not legally sustainable. It follows that the claims which depend from claim 61 are likewise allowable.

Claim 63

Claim 63 depends from claim 46. In the Action, claim 46 was not asserted to be anticipated by Blechl. It follows that claim 63, which includes the features and relationships of claim 46, is not anticipated by Blechl.

Claim 63 further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that "the reference surface extends adjacent to the holder, and prior to step (c) comprising reading the indicia on the reference surface."

The Action alleges that Blechl discloses reading indicia on the reference surface at col 8, lines 45-60. The Appellants disagree. The referenced section is directed to a brief description of the identification unit using passwords or IC cards. Blechl does not disclose "indicia" in the manner recited. Nor does Blechl disclose "reading the indicia" in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

Claim 64

Claim 64 depends from claim 46. In the Action, claim 46 was not asserted to be anticipated by Blechl. It follows that claim 64, which includes the features and relationships of claim 46, is not anticipated by Blechl.

Claim 64 further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the indicia includes indicia spaced in aligned, side by side relation on the reference surface, wherein the spaced indicia corresponds to different medical item sizes, and prior to step (c) further comprising determining the number of medical items held in the holder.”

The Action alleges that Blechl discloses determining the number of medical items held in the drawer at col 8, lines 45-60. The Appellants disagree. The referenced section is directed to a brief description of the identification unit using passwords or IC cards, and an input unit (248). Blechl does not disclose “indicia” in the manner recited. Nor does Blechl disclose “determining the number of medical items held in the holder” in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

Claim 65

Claim 65 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the module includes a latching lever, wherein the enclosure includes a latching pin, and further comprising engaging the latching lever with the latching pin to hold the module in the first position.”

The Action alleges that Blechl discloses engaging the latching lever with the latching pin to hold the module in the first position at col 7, lines 47-58. The Appellants disagree. The referenced section is directed to a solenoid (68) and an actuator arm (82). Blechl does not hold a module in a first position by engaging a latching lever with a latching pin in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

Claim 66

Claim 66 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “each module is movable in a direction toward the door from a respective first position, wherein each of the dispenser modules has a respective dispense location, wherein with the modules in the first position each dispense location is in different proximity in the direction relative to an adjacent module.”

The Action alleges that Blechl discloses dispensing a medical item from one of the dispenser modules at some lines 61-69. The Appellants disagree. No lines 61-69 in Blechl are directed to dispensing a medical item with one of the dispenser modules in the manner recited.

In claim 66, with the modules in the first position, each dispense location is in a different proximity in the movable direction toward the door relative to an adjacent module. That is, the dispense locations are in different proximity (e.g., relative to the door). For example, note Specification page 15, lines 4-10, and Figure 2.

Blechl does not disclose a door, or a dispense location, or a different proximity in the manner recited. Blechl does not disclose having each dispense location in different proximity in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

The Pending Claims Are Not Anticipated By Higham

In the Action claims 40, 42-43, 46-47, 63, and 66 were rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by Higham.

These rejections are respectfully traversed. Appellants traverse these rejections on the grounds that the Higham reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claims patentably distinguish over the Higham reference.

Furthermore, the Action has not stated where the specific features of Appellants' claims are allegedly found in the Higham reference. The Office was respectfully asked to clearly state on the record which specific (numbered) features in the Higham reference directly corresponded to the claimed dispenser, enclosure, dispenser module, holder, dispenser mechanism, and medical item. The previous failure of the Office to specifically indicate the presence of the recited claim features in the Higham reference constituted Agency Action under the Administrative Procedures Act admitting that the reference does not meet the recited claim features. Allowance of the claims is respectfully requested on this basis.

The Action alleges that Higham discloses moving a dispenser module from a position within the enclosure to a position outside the enclosure (col. 18, lines 43-44). The referenced

lines in Higham refer to a door (62), a rack (48), and an item (52) (Figures 3B and 3C).

However, as the rejection is best understood, it is unclear whether the Action alleges that Higham's rack (48) constitutes the dispenser module.

The Action further alleges that Higham discloses adding or removing at least one medical item from the holder while outside the enclosure (col. 18, lines 45-47). The referenced lines in Higham refer to a user manually removing an item (52).

The Action further alleges that Higham discloses moving the dispenser (sic) from outside the enclosure to within the enclosure such that the holder is within the enclosure (col. 22, lines 10-15). The referenced lines in Higham refer to a nurse closing a door (212). As the rejection is best understood, apparently Higham's alleged dispenser module has been switched from rack (48) to door (212). That is, as the rejection is best understood, it is unclear whether Higham's door (212) now allegedly constitutes the dispenser module.

It remains unclear as to what element in Higham constitutes the dispenser module. The Office has not clearly presented the rejection as is required by MPEP 707.07(d). Appellants have been left with the burden of trying to properly respond to an unclear Action.

On page 6 the Action also refers to "an apparatus structural limitation unutilized by any method limitation." However, the Action has not stated which specific structural feature is allegedly not a part of the method. Thus, since the Action has not stated the specific structural feature, Appellants are unable to respond to the allegation.

Claim 40

Claim 40 is an independent claim which is specifically directed to a method performed in connection with a dispenser. The claim specifically recites that the dispenser module “includes a holder enabling holding of medical items” and “a dispenser mechanism, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder.” Furthermore, the claim specifically recites that the dispenser module, while mounted, is movable “from a first position, wherein the dispenser module is within the enclosure, to a second position, wherein the holder extends outside the enclosure.”

In the operation of Higham, an item can be manually placed into or removed from a particular receptacle (36) of the withdrawn drawer (32) (col. 16, lines 37-45; col. 18, lines 43-47). Higham does not disclose a dispenser module including a “dispenser mechanism.” Nor does Higham disclose that the recited “dispenser mechanism” is “selectively operable to dispense medical items from the holder.” Higham’s manual removal of items actually teaches away from using the recited “dispenser mechanism” to dispense medical items. Higham does not disclose a “dispenser” in the manner recited.

Higham does not disclose a dispenser module including a dispenser mechanism as specifically recited. Higham does not disclose a dispenser mechanism selectively operable to dispense medical items from the holder. Higham also does not disclose a mounted dispenser module including a “holder” and “a dispenser mechanism”, and moving the mounted dispenser module in the manner recited.

The rejection does not even mention a “dispenser mechanism.” Nor does Higham disclose a “dispenser mechanism.” Nor does Higham disclose a “dispenser mechanism selectively operable to dispense medical items from the holder.” Nor does Higham disclose that a movably mounted dispenser module includes a dispenser mechanism. To make a valid rejection pursuant to 35 U.S.C. § 102 it must be shown by the Patent Office that Higham contains all the elements of the claimed invention arranged in the manner recited in the claim. Higham does not disclose a “dispenser mechanism” in the manner recited. It follows that Higham does not disclose moving a dispenser module which includes a dispenser mechanism. It further follows that Higham cannot anticipate the claim.

Higham’s rack (48) cannot constitute the dispenser module because it does not include a “dispenser mechanism” in the manner recited. Higham’s door (212) cannot constitute the dispenser module because it does not include a “dispenser mechanism” in the manner recited. Both the rack (48) and door (212) simply allow a user to access an item contained therein.

Higham does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejection. As Higham does not disclose the recited method, Appellants’ claim patentably distinguishes over the Higham reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection is improper and claim 40 should be allowed. It follows that the claims which depend from claim 40 are likewise allowable.

**The Dependent Claims Recite Features Which Further
Patentably Distinguish Over Higham**

There are also a number of features that are expressly recited in claims that depend from claim 40 that further distinguish the preferred embodiment of the present invention over the cited art.

Therefore, Higham does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required for a valid rejection. As Higham does not disclose the recited method, Appellants' claims patentably distinguish over the Higham reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections are further overcome due to recitation of these additional features in claims that depend from Claim 40.

Claim 42

Claim 42 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites "manually adding or removing at least one medical item from the holder."

As previously discussed, Higham does not disclose a dispenser module including a "dispenser mechanism" in the manner recited. It follows that Higham does not disclose the steps of "manually adding or removing at least one medical item from the holder" in combination with a "dispenser mechanism" that is "selectively operable to dispense medical items from the holder." Thus, it is respectfully submitted that the claim is further allowable.

Claim 43

Claim 43 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the dispenser further includes a path extending in the enclosure, wherein the path is in connection with a delivery area, whereby medical items are accessible to a user in the delivery area, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder at a dispense location.” The claim further recites moving the dispenser module “wherein the dispenser module is within the enclosure and the dispense location is positioned adjacent the path.” In Higham, an item (52) is removed manually. Higham does not disclose a “path” and “delivery area” and “dispense location” as recited. Nor does Higham have any need for such. Nor does Higham disclose the recited relationship of the “path” and “delivery area” and “dispense location.” Thus, it is respectfully submitted that the claim is further allowable.

Claim 46

Claim 46 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that a “reference surface includes indicia thereon indicative of the number of medical items in the holder.” The claim further recites “reading the indicia on the reference surface.” Higham does not disclose “indicia” on a “reference surface” in the manner recited. Nor does Higham disclose indicia “indicative of the number of medical items in the holder.” Thus, it is respectfully submitted that the claim is further allowable.

The Action alleges that Higham discloses reading indicia on a reference surface at col 5, lines 3-18. The referenced col 5, lines 3-18, appears directed to displaying types of items held by a unit. Higham does not disclose reading indicia on a reference surface. Higham does not disclose “indicia” or that a “reference surface includes indicia thereon” as recited in claim 46. Nor does Higham disclose reading indicia “indicative of the number of medical items in the holder.” As Higham fails to disclose such features, it is respectfully submitted that the claim is further allowable.

Claim 47

Claim 47 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. This claim specifically recites a cover movably mounted on the dispenser module and that “the cover is prevented from moving to the up position when the dispenser module is in the first position.” Higham does not disclose a “cover” in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

Claim 63

Claim 63 depends from claim 46 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the reference surface extends adjacent to the holder, and prior to step (c) comprising reading the indicia on the reference surface.”

The Action is silent with respect to the recited features of claim 63. Nevertheless, Higham does not disclose “indicia” on a “reference surface”, nor reading indicia “indicative of the number of medical items in the holder” in the manner recited (claim 46). Higham also does

not disclose “reading the indicia” prior to step (c). As Higham fails to disclose such features, it is respectfully submitted that the claim is further allowable.

Claim 66

Claim 66 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “each module is movable in a direction toward the door from a respective first position, wherein each of the dispenser modules has a respective dispense location, wherein with the modules in the first position each dispense location is in different proximity in the direction relative to an adjacent module.”

In claim 66, with the modules in the first position each dispense location is in a different proximity in the movable direction toward the door relative to an adjacent module. That is, the dispense locations are in different proximity (e.g., relative to the door). For example, note Specification page 15, lines 4-10, and Figure 2.

The Action references item (52) in Higham’s Figure 3. However, in Higham an item (52) is removed manually. Higham does not disclose a “dispense location.” Nor does Higham have any need for such. Higham does not disclose “dispensing” a medical item with a dispenser module. Nor does Higham disclose having each dispense location in different proximity in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

The Pending Claims Are Not Anticipated By Kraft

In the Action claims 40, 42-43, and 46-47 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kraft.

The Action alleges that Kraft discloses moving the dispenser module from a position within the enclosure to a position outside the enclosure (col. 5, lines 15-20); adding or removing at least one medical item from the holder while outside the enclosure (col. 13, lines 45-56); moving the dispenser from outside the enclosure to within the enclosure such that the holder is within the enclosure (col. 8, lines 8-38); manually adding or removing at least one medical item from the holder (col. 4, lines 35-50); moving the dispenser out of the enclosure so as to make it manually accessible (col. 13, lines 38-57); reading indicia on a reference surface (co. 9. lines 1-28; col. 7, lines 59-65); and moving the cover to the up position prior to moving the cover to the down position (col. 12, line 58 to col. 13, line 3).

These rejections are respectfully traversed. Appellants traverse these rejections on the grounds that the Kraft reference does not contain all the elements of the claimed invention arranged in the manner recited in the claims. The features recited in Appellants' claims patentably distinguish over the Kraft reference.

Furthermore, the Action has again not stated where the specific features of Appellants' claims are allegedly found in the Kraft reference. The Office was respectfully asked to clearly state on the record which specific (numbered) features in the Kraft reference allegedly directly correspond to the features of the dispenser, enclosure, dispenser module, holder, dispenser mechanism, and medical item as recited in the claim. The Action's failure (refusal) to

specifically indicate the presence of the recited claim features in the Kraft reference constitutes Agency Action under the Administrative Procedures Act which constitutes a legal admission by the Patent Office that the reference does not meet the recited claim features. Allowance of the claims is respectfully requested on this basis.

Kraft discloses a packaging system which uses robotics (40) for manipulating a selected container (90, 130) to transfer medication units from the container directly to a package (314). In operation, the bulk medication container (130) is manipulated by the robotics (40) to place a single medication unit in a discharge holding area (152) of the container. A helical ridge (136) acts as a ramp for pills (134) in the container (130). The container is rotated to drop the medication unit into an opening (334) in a pocket (314) of a packaging system (38) where the unit is sealingly packaged. Kraft's system uses robotics (40) to sealingly package a medication unit.

The Action alleges that Kraft discloses moving the dispenser module from a position within the enclosure to a position outside the enclosure (col. 5, lines 15-20). The referenced lines in Kraft refer to a dispenser (12) and a drawer (24). However, as the rejection is best understood, it is unclear whether the Action alleges that Kraft's drawer (24) allegedly constitutes the dispenser module.

The Action further alleges that Kraft discloses adding or removing at least one medical item from the holder while outside the enclosure (col. 13, lines 45-56). The referenced lines in Kraft refer to a scheduled medication drawer (356). However, as the rejection is best understood,

it is unclear whether the Action alleges that Kraft's drawer (24) is no longer the dispenser module, but drawer (356) now allegedly constitutes the dispenser module.

The Action further alleges that Kraft discloses moving the dispenser (sic) from outside the enclosure to within the enclosure such that the holder is within the enclosure (col. 8, lines 8-38). The referenced lines in Kraft refer to using the robotics (40) to load a container (130), and also mentions an access door (32). As the rejection is best understood, it is unclear whether the Action alleges that Kraft's dispenser module has again been switched. That is, it is unclear whether Kraft's drawer (356) is no longer asserted to be the dispenser module, but either the container (130) or the access door (32) now allegedly constitutes the dispenser module.

As can be seen, the rejection is incongruent both in substance and explanation. The rejection is an omnibus type rejection and does not permit understanding by Appellants. It remains unclear as to what element in Kraft constitutes the dispenser module. The Patent Office has not clearly presented the rejection as is required by MPEP 707.07(d). Appellants have been left with the burden of trying to properly respond to an unclear Action. As the rejection is clearly legally insufficient Appellants request that it be withdrawn.

Claim 40

Claim 40 is an independent claim which is specifically directed to a method performed in connection with a medical item dispenser. The claim specifically recites that the dispenser module "includes a holder enabling holding of medical items" and that "the dispenser module further includes a dispenser mechanism, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder." Furthermore, the claim specifically recites that the

dispenser module, while mounted, is movable “from a first position, wherein the dispenser module is within the enclosure, to a second position, wherein the holder extends outside the enclosure.”

Kraft does not disclose a dispenser module that includes a dispenser mechanism as recited. Kraft does not disclose a dispenser mechanism selectively operable to dispense medical items from the holder. Nor does Kraft disclose a mounted dispenser module including a “holder” and “a dispenser mechanism”, and the step of moving the mounted dispenser module in the manner recited.

The rejection does not even mention a “dispenser mechanism.” Nor does Kraft disclose a “dispenser mechanism.” Nor does Kraft disclose a “dispenser mechanism selectively operable to dispense medical items from the holder.” Nor does Kraft disclose a movably mounted dispenser module that includes a dispenser mechanism. Anticipation pursuant to 35 U.S.C. § 102 would require that Kraft contain all the elements of the claimed invention arranged in the manner recited in the claim. Kraft does not disclose a “dispenser mechanism” in the manner recited. It follows that Kraft does not disclose the recited step of moving a dispenser module which includes a dispenser mechanism.

Kraft’s drawer (24) cannot constitute the dispenser module because it does not include a “dispenser mechanism” as specifically recited. The drawer (24) simply allows a nurse to access medication contained therein. Kraft’s scheduled medication drawer (356) likewise cannot constitute the dispenser module because it does not include a “dispenser mechanism” as recited. The scheduled medication drawer (356) simply allows a nurse to remove packages from the

drawer (356). Neither Kraft's container (130) or access door (32) can constitute the dispenser module because neither includes a "dispenser mechanism" in the manner recited. Furthermore, neither of Kraft's container (130) nor access door (32) is moved, "while mounted, from a first position, wherein the dispenser module is within the enclosure, to a second position, wherein the holder extends outside the enclosure."

Kraft does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejection. As Kraft does not disclose the recited method, Appellants' claim patentably distinguishes over the Kraft reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102 rejection has been overcome. It follows that the claims which depend from claim 40 are likewise allowable.

**The Dependent Claims Recite Features Which Further
Patentably Distinguish Over Kraft**

There are also a number of features that are expressly recited in claims that depend from claim 40 that further distinguish the preferred embodiment of the present invention over the cited art.

Kraft does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required for a valid rejection. Kraft does not disclose or suggest the recited methods. Hence, Appellants' claims patentably distinguish over the Kraft reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections have been further overcome due to recitation of additional features as discussed below.

Claim 42

Claim 42 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “manually adding or removing at least one medical item from the holder.”

As previously discussed, Kraft does not disclose a movably mounted dispenser module including a “dispenser mechanism” in the manner recited. It follows that Kraft cannot disclose “manually adding or removing at least one medical item from the holder” in combination with a “dispenser mechanism” that is “selectively operable to dispense medical items from the holder.” Further, Kraft does not disclose “manually adding or removing at least one medical item from the holder” “while the holder extends outside the enclosure.” It is respectfully submitted that claim 42 is further allowable for these reasons.

The referenced col. 4, lines 35-50, is directed to personnel loading and removing containers through an access window (32). These containers do not constitute a dispenser module, nor are they moved while mounted as is specifically recited. Nor does Kraft disclose such. Thus, it is respectfully submitted that the rejection is invalid and that the claim is further allowable.

Claim 43

Claim 43 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the dispenser further includes a path extending in the enclosure, wherein the path is in connection with a delivery area, whereby medical items are accessible to a user in the delivery area, wherein the

dispenser mechanism is selectively operable to dispense medical items from the holder at a dispense location.” Kraft does not disclose such a “path” and “delivery area” and “dispense location” as recited. Nor does Kraft disclose the recited relationship of the “path” and “delivery area” and “dispense location.” Thus, it is respectfully submitted that claim 43 is further allowable on this basis.

The referenced col. 13, lines 38-57, is directed to a nurse being able to remove packages from a drawer (356). Neither the packages nor the drawer (356) constitute a dispenser module as recited. Kraft does not disclose or suggest such features. Thus, it is respectfully submitted that the claim is further allowable.

Claim 46

Claim 46 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that a “reference surface includes indicia thereon indicative of the number of medical items in the holder.” The claim further recites “reading the indicia on the reference surface.” Kraft does not disclose “indicia” on a “reference surface” as recited. Nor does Kraft disclose indicia “indicative of the number of medical items in the holder.” Thus, it is respectfully submitted that claim 46 is further allowable on this basis.

The referenced col. 9, lines 1-28 of Kraft, is directed to detection of medication units in an area. The referenced col. 7, lines 59-65, is directed to a label containing information on the type of medication stored. However, neither referenced section of Kraft is directed to reading

indicia “indicative of the number of medical items in the holder.” Nor does Kraft disclose such. Thus, it is respectfully submitted that the claim is further allowable.

Claim 47

Claim 47 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites a cover movably mounted on the dispenser module and that “the cover is prevented from moving to the up position when the dispenser module is in the first position.” Kraft does not disclose such a “cover” in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

The referenced col. 12, line 58 to col. 13, line 3, is directed to detecting whether a pill has landed in the package. The referenced section of Kraft is clearly not directed to a cover movably mounted on a dispenser module in the manner recited. Nor does Kraft disclose such. Thus, it is respectfully submitted that claim 47 is further allowable on this basis.

The Pending Claims Are Not Anticipated By Williams

In the Action claims 65-66 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Williams.

Claim 65

Claim 65 depends from claim 40. In the Action, claim 40 was not asserted to be anticipated by Williams. It follows that claim 65, which includes the features and relationships of claim 40, is not anticipated by Williams.

Claim 65 further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the module includes a latching lever, wherein the enclosure includes a latching pin, and further comprising engaging the latching lever with the latching pin to hold the module in the first position.”

The Action alleges that Williams discloses engaging a latching lever with a latching pin to hold the module in the first position at col 6, lines 39-60. The Appellants disagree. Williams does not disclose a “latching pin” in the manner recited. It follows that Williams does not hold a module in a first position by engaging a latching lever with a latching pin in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

Claim 66

Claim 66 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “each module is movable in a direction toward the door from a respective first position, wherein each of the dispenser modules has a respective dispense location, wherein with the modules in the first position each dispense location is in different proximity in the direction relative to an adjacent module.”

The Action alleges that Williams discloses dispensing a medical item from one of the dispenser modules at col. 7, lines 30-50. The Appellants disagree. The Action is silent as to what feature, if any, in Williams is asserted to correspond to the recited “dispenser module.” Thus, it is respectfully submitted that claim 66 is further allowable.

In claim 66, with the modules in the first position each dispense location is in a different proximity in the movable direction toward the door relative to an adjacent module. That is, the dispense locations are in different proximity (e.g., relative to the door). For example, note Specification page 15, lines 4-10, and Figure 2.

Williams does not disclose a dispenser including a dispenser module movably mounted in supporting connection with an enclosure. Nor does Williams disclose the dispenser module having a holder for holding plural medical items in the manner recited. Nor does Williams disclose the dispenser module having a dispenser mechanism selectively operable to dispense medical items from the holder in the manner recited. In Williams a single dose is manually “dispensed” by requiring a user to manually open a door and remove a single medical item, not by a using a selectively operable dispenser mechanism to mechanically dispense a plurality of medical items from a holder. Furthermore, Williams requires the manual removal of the single medical item prior to permitting further manual dispensing of another (plural) medical item. Williams’ required manual removal of items teaches away from using the recited “dispenser mechanism” to dispense medical items. Additionally, Williams does not disclose having each “dispense location” in a different proximity in the manner recited. Also, Williams does not disclose having plural dispenser modules movable relative to a door. Thus, it is respectfully submitted that the claim is further allowable.

(iv) **35 U.S.C. § 103**

The Pending Claims Are Not Obvious in View of Higham

In the Action claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied reference.

The Action admits that Higham does not disclose the step of closing the door, or a cylindrical holding container containing a liquid. The Action asserts that it would have been obvious to close the door in Higham.

The Appellants disagree. Higham lacks many of the recited features. Higham does not disclose or suggest many features and relationships that are specifically recited in the claims.

Claims 40, 42, 43, 46-47, 63, and 66

Claims 40, 42, 43, 46-47, 63, and 66 have already been discussed in regards to specifically recited features not found in the Higham reference. Appellants' arguments concerning the Higham reference discussed above in support of the patentability of these claims are incorporated by reference as if fully rewritten herein.

Higham does not disclose or suggest the recited method. As nothing in the Higham reference discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited in Higham for combining features of the cited reference so as to produce Appellants' invention, it is respectfully submitted that these claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections are improper and should be withdrawn.

Claim 41

Claim 41 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites "moving the door of the enclosure from a closed position to an open position, wherein the holder is able to be moved outside the enclosure" and "closing the door." Higham does not disclose or suggest "moving the door" in the manner recited. Furthermore, even the Action (page 9, line 4) admits that Higham does not disclose the step of "closing the door." Thus, it is respectfully submitted that claim 41 is further allowable on this basis.

Claim 49

Claim 49 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites "a further dispenser module in the interior area" and "dispensing a first medical item including a supporting card from the dispenser module" and "dispensing a second medical item including a generally cylindrical liquid holding container from the further dispenser module."

The Action alleges that Higham discloses dispensing a supporting card from the module (col 18, lines 1-15; Figure 3, #52). However, Higham's item (52) is a catheter. Higham does not disclose or suggest "a further dispenser module" or dispensing "a supporting card" in the manner recited. Thus, it is respectfully submitted that claim 49 is further allowable.

Higham also does not disclose or suggest dispensing a "liquid holding container." The Action alleges that Higham shows a cylindrical holding container (260). However, there is no indication that this alleged container is a "liquid holding container" in the manner recited. Even the Action (page 9, line 5) admits that Higham does not disclose a cylindrical liquid holding container. Nevertheless, even if it were somehow possible for the container (260) to contain a liquid, it would still not be capable of being dispensed in the manner recited. Thus, it is respectfully submitted that the claim is further allowable on this basis.

Claim 52

Claim 52 is an independent claim which is specifically directed to a method performed in connection with a medical item dispenser. The claim specifically recites that the dispenser module "includes a holder enabling holding of medical items" and "a dispenser mechanism, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder." Furthermore, the claim specifically recites that the dispenser module, while mounted in supportive connection with the enclosure, is movable "from a first position, wherein the dispenser module is within the enclosure, to a second position, wherein the holder extends outside the enclosure."

Higham does not disclose or suggest a dispenser module including a dispenser mechanism as recited. Higham does not disclose or suggest a dispenser mechanism selectively operable to dispense medical items from a holder. Higham further does not disclose or suggest a mounted dispenser module including a “holder” and “a dispenser mechanism”, and moving the mounted dispenser module in the manner recited.

In the operation of Higham, an item can be manually placed into or removed from a particular receptacle (36) of the withdrawn drawer (32) (col. 16, lines 37-45; col. 18, lines 43-47). Higham does not disclose or suggest a dispenser module including a “dispenser mechanism.” The recited “dispenser mechanism” of Appellants’ claim is “selectively operable to dispense medical items from the holder.” Higham’s manual removal of items teaches away from using the recited “dispenser mechanism” to dispense medical items. Higham clearly does not disclose or suggest a “dispenser” or the method steps specifically recited.

As nothing in the Higham reference discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited reference so as to produce Appellants’ invention, it is respectfully submitted that the claim is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

Claim 53

Claim 53 is an independent claim which is specifically directed to a method performed with a medical item dispenser apparatus. The claim specifically recites that the dispenser module “includes a holder, wherein the holder enables holding the medical items” and “a dispenser

mechanism, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder.” Furthermore, the claim specifically recites that the dispenser module, while mounted, is movable “from a first position, wherein the dispenser module is within the enclosure, to a second position, wherein the holder extends outside the enclosure.”

Higham does not disclose or suggest a dispenser module including a dispenser mechanism as recited. Higham does not disclose or suggest a dispenser mechanism selectively operable to dispense medical items from the holder. Higham also does not disclose nor suggest a mounted dispenser module including a “holder” and “a dispenser mechanism”, and moving the mounted dispenser module in the manner recited.

In the operation of Higham, an item can be manually placed into or removed from a particular receptacle (36) of the withdrawn drawer (32) (col. 16, lines 37-45; col. 18, lines 43-47). Higham does not disclose or suggest a dispenser module including a “dispenser mechanism.” The “dispenser mechanism” as recited in claim 53 is “selectively operable to dispense medical items from the holder.” Higham’s manual removal of items teaches away from using the recited “dispenser mechanism” to dispense medical items. It is clear that Higham does not disclose or suggest a “dispenser” or the method steps as recited.

As nothing in the Higham reference discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited reference so as to produce Appellants’ invention, it is respectfully submitted that the claim is allowable. Therefore, it is respectfully

submitted that the 35 U.S.C. § 103(a) rejection has been overcome, and the rejection of claim 53 withdrawn.

Claim 54

Claim 54 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “manually adding or removing at least one medical item from the holder.” Higham does not disclose or suggest “manually adding or removing at least one medical item from the holder” in the manner recited. Thus, it is respectfully submitted that claim 54 is further allowable on this basis.

Claim 57

Claim 57 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that a “reference surface includes indicia thereon indicative of numbers of medical items held in the holder.” The claim further recites “reading the indicia on the reference surface.” Higham does not disclose or suggest “indicia” on a “reference surface” in the manner recited. Nor does Higham disclose or suggest indicia “indicative of numbers of medical items in the holder.” Thus, it is respectfully submitted that the claim is further allowable on this basis.

The Action alleges that Higham discloses reading indicia on a reference surface at col 5, lines 3-18. However, the referenced col 5, lines 3-18, appears directed to displaying types of items held by a unit. Higham does not disclose reading indicia on a reference surface. Higham does not disclose “indicia” nor that a “reference surface includes indicia thereon” as specifically

recited. Nor does Higham disclose reading indicia “indicative of numbers of medical items in the holder.” Thus, it is respectfully submitted that claim 57 is further allowable on this basis.

Claim 58

Claim 58 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the cover is prevented from moving to the up position when the dispenser module is in the first position.” Higham does not disclose or suggest a “cover” in the manner recited. Thus, it is respectfully submitted that claim 58 is further allowable for this reason.

Claim 60

Claim 60 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “a further dispenser module in the interior area” and “dispensing a first medical item including a supporting card from the dispenser module” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further dispenser module.”

The Action alleges that Higham discloses dispensing a supporting card from the module (col 18, lines 1-15; Figure 3, #52). However, Higham’s item (52) is a catheter. Higham does not disclose or suggest “a further dispenser module” or dispensing “a supporting card” in the manner recited. Thus, it is respectfully submitted that claim 60 is further allowable.

Higham also does not disclose or suggest dispensing a “liquid holding container.” The Action alleges that Higham shows a cylindrical holding container (260). However, there is no indication that this alleged container is a “liquid holding container” in the manner recited.

Nevertheless, the container (260) is not capable of being dispensed in the manner recited. Thus, it is respectfully submitted that claim 60 is further allowable on this basis.

Claim 62

Claim 62 depends from claim 61. In the Action, claim 61 was not rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham. It follows that claim 62, which includes the features and relationships of claim 61, is not unpatentable over Higham.

Claim 62 further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “dispensing a first medical item including a supporting card from the first dispenser module.”

As previously discussed, Higham does not disclose or suggest dispensing a supporting card from a dispenser module. The Action alleges that Higham discloses dispensing a supporting card from the module (col 18, lines 1-15; Figure 3, #52). However, Higham’s item (52) is a catheter. Higham does not disclose or suggest “a second dispenser module” or dispensing “a supporting card” in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

Higham also does not disclose or suggest dispensing a “liquid holding container.” The Action alleges that Higham shows a cylindrical holding container (260). However, there is no indication that this alleged container is a “liquid holding container” in the manner recited. Nevertheless, the container (260) is not capable of being dispensed in the manner recited. Thus, it is respectfully submitted that claim 62 is further allowable on this basis.

Claim 67

Claim 67 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the dispenser module includes a further holder.” The claim further recites “dispensing a first medical item including a supporting card from the holder” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further holder.”

The Action is silent with respect to the recited features of claim 67. However, the Action alleges (with regard to other claims) that Higham discloses dispensing a supporting card from the module (col 18, lines 1-15; Figure 3, #52). However, as previously discussed, Higham’s item (52) is a catheter. Higham does not disclose or suggest “a further dispenser module” or dispensing “a supporting card” in the manner recited. Thus, it is respectfully submitted that claim 67 is further allowable.

Higham also does not disclose or suggest dispensing a “liquid holding container.” The Action alleges that Higham shows a cylindrical holding container (260). However, as previously discussed, there is no indication that this alleged container is a “liquid holding container” in the manner recited. Nevertheless, the container (260) is not capable of being dispensed in the manner recited. Thus, it is respectfully submitted that claim 67 is further allowable on this basis.

**The Pending Claims Are Not Obvious Over
Higham in view of Kraft**

In the Action claims 40-44, 46-49, 52-60, 62-64, and 66-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Kraft. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

The Office Action admits that Higham does not disclose “engaging a helix within the holder a rotating mechanism”; “engaging a holder guide”; “placing a medical item in engagement with each of a pair of helixes”; “extending a limiting member within the inside of the helix”; and “determining the number of medical items held in the drawer.” The Office Action asserts that Kraft discloses such features. The Office Action further asserts that it would have been obvious for Higham to have such features.

The Appellants disagree. Higham lacks many of the features and relationships that are specifically recited in the claims. Kraft lacks the capability of adding the recited features that are not found in Higham. Neither Higham nor Kraft alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims.

As nothing in the cited references disclose nor suggest the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' claimed

invention, it is respectfully submitted that these claims are allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66-67

Appellants' arguments concerning the Higham reference discussed above in support of the patentability of claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66-67 are incorporated by reference as if fully rewritten herein. Kraft does not disclose or suggest the features or relationships that are not found in Higham.

As previously discussed, in the operation of Higham, an item can be manually placed into or removed from a particular receptacle (36) of a withdrawn drawer (32) (col. 16, lines 37-45; col. 18, lines 43-47). Higham does not disclose or suggest a dispenser module including a "dispenser mechanism." Furthermore, the recited "dispenser mechanism" of Appellants' referenced claims is "selectively operable to dispense medical items from the holder." Higham's manual removal of items teaches away from using the recited "dispenser mechanism" to dispense medical items.

Kraft's packaging system uses robotics (40) for manipulating a selected container (90, 130) to transfer medication units from the container directly to a package (314). In operation, the bulk medication container (130) is manipulated by the robotics (40) to place a single medication unit in a discharge holding area (152) of the container. A helical ridge (136) acts as a ramp for pills (134) in the container (130). The container is rotated to drop the medication unit into an opening (334) in a pocket (314) of a packaging system (38) where the unit is sealingly packaged.

Kraft's system uses robotics (40) to package a medication unit in a sealed condition. In Higham an item is manually placed or removed from a drawer. Therefore, it would not have been obvious to modify Higham as alleged.

The Action is silent as to what feature, if any, in Kraft constitutes the alleged helix. It is unclear whether Kraft's helical ridge (136) is the alleged helix. Nevertheless, Kraft's helical ridge (136) acts as a ramp for pills (134) in the container (130). The container is rotated to drop the medication unit into an opening (334) in a pocket (314) of a packaging system (38). Hence, the helical ridge (136) is used in the packaging of medication. In Higham a medical item is not capable of being dropped to a lower location. In Higham's operation a drawer is opened and an item is manually removed. Higham's operation is simple and straight forward. In Higham there is no dispenser mechanism because the items are manually removed from the drawer. Hence, Higham has no need, desire, or use for the recited helix. There can be no suggestion or motivation derived from the teachings of Higham to include such a helix therein.

Furthermore, the robotic packaging system of Kraft is contrary to the manual drawer system of Higham. The assertion in the Action concerning incorporation of a helix into Higham is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is impermissible. The Action has not shown any reason or motivation to combine, or explained how a helix could be incorporated into the manually operated drawer system of Higham. The Action has not shown any reason or motivation why one skilled in the art would attempt to incorporate a helix into the manually operated drawer system of Higham. When a drawer of Higham is opened, then the items are readily accessible. A helix, even if it were somehow

possible to install in Higham, would serve no purpose. Thus, Higham would not be improved with the addition of a helix. Clearly, one skilled in the art would have no reason to have attempted to incorporate a helix into the manually operated drawer system of Higham. Any alleged modification involving a helix, if it were even somehow possible, would appear to destroy the utility or advantage of Higham and render the disclosed device of Higham inoperable.

A reference teaching away from the recited invention does not support prima facie obviousness. It is improper to reconstruct the invention from the disclosure of the Appellants. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). As the combination of features asserted in the Action would destroy the utility and advantages of the cited references, it is respectfully submitted that the rejection is improper and should be withdrawn.

In regard to claims 52 and 53 Higham additionally lacks the recited path and delivery area. The arrangement of Higham's drawer system cannot support the features and relationships of a path and a delivery area. Therefore, even if Kraft disclosed these features and relationships, it would not have been obvious to have included these features and relationships into Higham.

Neither Higham nor Kraft alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. Neither Higham nor Kraft alone or in combination disclose or suggest the recited method.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited

for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66-67 are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It follows that the claims which depend from these claims are likewise allowable.

Appellants further wish to point out further features recited in dependent claims that further patentably distinguish the exemplary embodiment of the invention.

Claim 44

Claim 44 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites "the holder includes the helix." The claim further recites "engaging a holder guide in operative connection with the dispenser module, wherein a first portion of the holder guide is extended in an inside area within the helix and a second portion of the holder guide extends in an exterior area outside of the helix." Neither Higham nor Kraft alone or in combination disclose or suggest that a "holder includes the helix" and a "holder guide" in the manner recited. Neither Higham nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, this referenced section of Kraft lacks the recited "helix" and "holder guide." Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included Higham with such features. Thus, it is respectfully submitted that claim 44 is further allowable.

Claim 48

Claim 48 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the holder includes a rotatable helix.” The claim further recites “extending a limiting member in the inside area of the helix, wherein the limiting member is operative to prevent a medical item from passing through the inside area of the helix absent rotation of the helix.” Neither Higham nor Kraft alone or in combination disclose or suggest a “rotatable helix” and a “limiting member” in the manner recited. Neither Higham nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, this referenced section of Kraft lacks the recited “rotatable helix” and “limiting member.” Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included such features in Higham. Thus, it is respectfully submitted that claim 48 is further allowable on this basis.

Claim 55

Claim 55 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “the holder includes the helix.” The claim further recites “engaging a holder guide in operative connection with the dispenser module, wherein a first portion of the holder guide is extended in an inside area within the helix and a second portion of the holder guide extends in an exterior area outside of the helix.” Neither Higham nor Kraft alone or in combination disclose or suggest that a “holder

includes the helix” and a “holder guide” in the manner recited. Neither Higham nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, this referenced section of Kraft lacks the recited “helix” and “holder guide.” Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included Higham with such features. Thus, it is respectfully submitted that claim 55 is further allowable on this basis.

Claim 56

Claim 56 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “the holder includes a pair of rotatable helixes.” Neither Higham nor Kraft alone or in combination disclose or suggest that a “holder includes a pair of rotatable helixes” in the manner recited. Neither Higham nor Kraft alone or in combination disclose or suggest the recited method.

The Action cites to Kraft at col. 5, lines 21-37; col. 7, lines 26-38; and col. 8, lines 25-67. However, these referenced sections of Kraft lacks the recited “pair of rotatable helixes.” Nor does Kraft disclose such features in the manner recited in the claim. Nor would it have been obvious to have included such features with the method of operation of Higham. Thus, it is respectfully submitted that claim 56 is further allowable.

Claim 59

Claim 59 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the holder includes a rotatable helix.” The claim further recites “extending a limiting member in the inside

area of the helix, wherein the limiting member is operative to prevent a medical item from passing through the inside area of the helix absent rotation of the helix.” Neither Higham nor Kraft alone or in combination disclose or suggest a “rotatable helix” and a “limiting member” in the manner recited. Neither Higham nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, this referenced section of Kraft lacks the recited “rotatable helix” and “limiting member.” Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included such features in Higham. Thus, it is respectfully submitted that claim 59 is further allowable on this basis.

Claim 64

Claim 64 depends from claim 46 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the indicia includes indicia spaced in aligned, side by side relation on the reference surface, wherein the spaced indicia corresponds to different medical item sizes, and prior to step (c) further comprising determining the number of medical items held in the holder.”

The Action admits that Higham does not disclose “determining the number of medical items held in the drawer.” The Action alleges that Kraft discloses determining the number of medical items held in the drawer at col. 5, lines 38-65. The Appellants disagree. Kraft does not disclose “indicia” on a “reference surface” as recited. It follows that Kraft does not disclose that the “spaced indicia corresponds to different medical item sizes.” The referenced section is not directed to the recited indicia features, nor determining the number of medical items held in the

holder in the manner recited. Thus, it is respectfully submitted that the claim is further allowable.

Claim 65

Claim 65 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the module includes a latching lever, wherein the enclosure includes a latching pin, and further comprising engaging the latching lever with the latching pin to hold the module in the first position.”

The Action is silent with respect to the recited features of claim 65. The Action is silent as to what feature, if any, in Higham or Kraft is asserted to correspond to the recited “latching lever” and “latching pin.” Nevertheless, neither Higham nor Kraft disclose or suggest “engaging the latching lever with the latching pin to hold the module.” It follows that neither Higham nor Kraft alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that claim 65 is further allowable.

**The Pending Claims Are Not Obvious Over
Kraft in view of Pitel**

In the Action claims 40-49, 52-60, and 62-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kraft in view of Pitel. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants’ claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Appellants’ invention. The features recited in Appellants’ claims patentably distinguish over the applied references.

The Action alleges that Kraft discloses moving the dispenser module from a position within the enclosure to a position outside the enclosure (col. 5, lines 15-20); adding or removing at least one medical item from the holder while outside the enclosure (col. 13, lines 45-56); moving the dispenser from outside the enclosure to within the enclosure such that the holder is within the enclosure (col. 8, lines 8-38); manually adding or removing at least one medical item from the holder (col. 4, lines 35-50); moving the dispenser out of the enclosure so as to make it manually accessible (col. 13, lines 38-57); reading indicia on a reference surface (col. 9, lines 1-28; col. 7, lines 59-65); and moving the cover to the up position prior to moving the cover to the down position (col. 12, line 58 to col. 13, line 3). The Action further alleges that Kraft discloses placing a dispensate medical item in engagement with each of a helix.

The Action admits that Kraft does not disclose “placing a dispensate item in contact with a pair of helixes” (claims 45 and 56). The Action alleges that Pitel discloses placing a dispensate item in contact with a pair of helixes. The Action further alleges that it would have been obvious for Kraft to place the dispensate in contact with a second helix because dual helixes are more reliable and more flexible in the size and width of dispensed products than are single helix dispensers.

The Appellants disagree. Kraft does not disclose or suggest many of the features and relationships that are specifically recited in the claims. Pitel does not overcome the deficiencies of Kraft as Pitel does not disclose or suggest the recited features which are not found in Kraft. Further, neither Kraft nor Pitel alone or in combination disclose or suggest the features and

relationships that are specifically recited in the claims. Neither Kraft nor Pitel alone or in combination disclose the recited method steps.

As nothing in the cited references disclose nor suggest the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that these claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Kraft's packaging system uses robotics (40) for manipulating a selected container (90, 130) to transfer medication units from the container directly to a package (314). In operation, the bulk medication container (130) is manipulated by the robotics (40) to place a single medication unit in a discharge holding area (152) of the container. A helical ridge (136) acts as a ramp for pills (134) in the container (130). The container is rotated to drop the medication unit into an opening (334) in a pocket (314) of a packaging system (38) where the unit is placed in a sealed package. Kraft's system uses robotics (40) to place a medication unit in a sealed package.

The Action is silent as to what feature, if any, in Kraft constitutes the alleged helix. It is unclear whether Kraft's helical ridge (136) is the alleged helix. Nevertheless, Kraft's helical ridge (136) acts as a ramp for pills (134) in the container (130). The container is rotated by robotics (40) to move a pill along the helical ridge (136) to drop the pill into an opening (334) of a pocket (314) of a packaging system (38). Hence, the helical ridge (136) is used in the packaging of medication.

It is not reasonable, nor has the Action explained, how Kraft could be modified to include Pitel's dual helixes as alleged. Kraft desires (col. 8, lines 8-10) to place a single pill (134) in the area (152) of a discharging element (146). The container (130) is rotated so that the pill travels along the helical ridge (136) to the area. It is unexplained how another helical ridge would be arranged in the container as alleged or any benefit therefrom. Nor is it clear how a small pill could even contact dual helical ridges as alleged. Even if it were somehow possible to arrange another helical ridge in the container, it would still be unclear how dual helical ridges would be somehow "more reliable and more flexible in the size and width" for a single pill.

Kraft desires that a single pill travel along the helical ridge (136). Therefore, it is unclear how an additional helical ridge would contribute to the travel of a single pill. Realistically, it would appear that the addition of another helical ridge would interfere with the operation of Kraft's desired pill movement. Any modification of Kraft's single helical ridge arrangement, if it were even somehow possible, would destroy the utility or advantage of Kraft and render the disclosed device of Kraft inoperable. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

The Action has admitted (paragraph number 14) that Pitel does not disclose that the item removed and placed within Pitel's dispenser is a medical item. It is specifically stated that Pitel's machine is specifically designed and sized to dispense large articles such as "bagged snacks" (col. 1, lines 13-15; and col. 2, lines 64-66). As is well known, "bagged snacks" such as chips

and pretzels are a common vending machine product. A common bag of chips is far removed from the specifically recited “medical item” dispensed through Appellants' method. The Appellants respectfully assert that the dispensing of medical items is in a totally different field of art than that of vending bagged snacks. Pitel is non-analogous art.

Furthermore, a helix arrangement in a dispensing machine is specifically designed and sized for the specific product to be dispensed. Pitel requires the use of a pair of large helices (106, 108) for holding and dispensing the “bagged snacks.” These helices are clearly too large for use in handling Kraft’s small-sized single pill. One having ordinary skill in the art would not have found it obvious to add to Kraft a helix as shown by Pitel to move the desired single pill.

Kraft desires that a small-sized single pill travel along the helical ridge (136). Pitel is directed to moving large sized bagged snacks. Pitel uses a supporting bar (128) upon which rest the bagged snacks moved by the helices. Such an arrangement could not be used in Kraft because the small-sized pill would remain resting on the support bar (128) and not be moved. In other words, Kraft’s small-sized pill would not make contact with Pitel’s helix. One having ordinary skill in the art would not have found it obvious to add to the structure of Kraft dual helices as shown by Pitel to move the desired single pill. Such a structure would not operate to perform Kraft's purpose.

Any attempt to incorporate dual helices into Kraft is clearly an attempt at hindsight reconstruction of Appellants’ claimed invention, which is legally impermissible. Furthermore, the Action has not shown any reason or motivation in the art to combine, or explained how, dual helices could be incorporated into the arrangement of Kraft. Furthermore, the Action has not

shown any reason or motivation why one skilled in the art would attempt to incorporate dual helixes into the arrangement of Kraft. Dual helixes, even if they were somehow possible to install in Kraft, would serve no useful purpose. Thus, Kraft would not be improved with the addition of dual helixes. Clearly, one skilled in the art would not have any reason to even attempt to incorporate dual helixes into the system of Kraft.

It is respectfully asserted that the rejection based on the asserted combination of features in Kraft and Pitel is legally improper, and should be withdrawn.

A detailed discussion of specific features in each claim is further presented herein, additionally explaining why Appellants' claimed methods are neither disclosed nor suggested by features in Kraft or Pitel. Furthermore, Appellants' arguments concerning the Kraft reference discussed above in support of the patentability of claims 40, 42, 43, and 46-47 are incorporated by reference as if fully rewritten herein.

Claim 40

Pitel lacks the capability of adding the recited features that are not found in Kraft. Neither Kraft nor Pitel alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims.

Neither Kraft nor Pitel alone or in combination disclose or suggest that a "dispenser module further includes a dispenser mechanism, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder" nor that the dispenser module, "while mounted", is movable "from a first position, wherein the dispenser module is within the

enclosure, to a second position, wherein the holder extends outside the enclosure.” Neither Kraft nor Pitel alone or in combination disclose the recited method.

As admitted (paragraph number 14) by the Office, Pitel is not associated with a medical item. Pitel does not overcome the deficiencies of Kraft as Pitel does not disclose or suggest the recited features which are not found in Kraft.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features so as to produce Appellants’ invention, it is respectfully submitted that claim 40 is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It further follows that the claims which depend from claim 40 are likewise allowable.

Claim 41

Claim 41 depends from claim 40 and recites further features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest “moving the door of the enclosure from a closed position to an open position, wherein the holder is able to be moved outside the enclosure” and “closing the door” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 41 is further allowable.

Claim 42

Claim 42 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination

disclose or suggest “manually adding or removing at least one medical item from the holder” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 42 is further allowable.

Claim 43

Claim 43 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that “the dispenser further includes a path extending in the enclosure, wherein the path is in connection with a delivery area, whereby medical items are accessible to a user in the delivery area, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder at a dispense location” as recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 43 is further allowable for these reasons.

Claim 44

Claim 44 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that “the holder includes the helix” or “engaging a holder guide in operative connection with the dispenser module, wherein a first portion of the holder guide is extended in an inside area within the helix and a second portion of the holder guide extends in an exterior area outside of the helix” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 44 is further allowable.

Claim 45

Claim 45 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest “placing a medical item in engagement with each of the helixes in the pair” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 46

Claim 46 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that a “reference surface includes indicia thereon indicative of the number of medical items in the holder” or the step of “reading the indicia on the reference surface” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 45 is further allowable on this basis.

Claim 47

Claim 47 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest a cover movably mounted on a dispenser module, and that “the cover is prevented from moving to the up position when the dispenser module is in the first position” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 48

Claim 48 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination, disclose or suggest that “the holder includes a rotatable helix” or “extending a limiting member in the inside area of the helix, wherein the limiting member is operative to prevent a medical item from passing through the inside area of the helix absent rotation of the helix” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 48 is further allowable on this basis.

Claim 49

Claim 49 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel either alone or in combination, disclose or suggest “a further dispenser module in the interior area” and “dispensing a first medical item including a supporting card from the dispenser module” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further dispenser module” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 52

Claim 52 is an independent claim. Claim 52 is specifically directed to a method performed in connection with a medical item dispenser. Neither Kraft nor Pitel alone or in combination disclose or suggest that a dispenser module “includes a holder enabling holding of medical items” and “a dispenser mechanism is selectively operable to dispense medical items

from the holder” and “adding or removing at least one medical item from the holder” in the manner recited. Neither Kraft nor Pitel, alone or in combination, disclose the recited method.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in claim 52, and because there is no teaching, suggestion or motivation cited for combining features so as to produce Appellants’ invention, it is respectfully submitted that claim 52 is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 53

Claim 53 is an independent claim which is specifically directed to a method performed in connection with a medical item dispenser apparatus. Neither Kraft nor Pitel alone or in combination, disclose or suggest that a dispenser module includes a holder enabling “holding of medical items” and that “a dispenser mechanism is selectively operable to dispense medical items from the holder” and “adding or removing at least one medical item from the holder” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features so as to produce Appellants’ invention, it is respectfully submitted that claim 53 is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome and that the claims which depend from claim 53 are likewise allowable.

Claim 54

Claim 54 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest “manually adding or removing at least one medical item from the holder” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 54 is further allowable on this basis.

Claim 55

Claim 55 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that “the holder includes the helix” or “engaging a holder guide in operative connection with the dispenser module, wherein a first portion of the holder guide is extended in an inside area within the helix and a second portion of the holder guide extends in an exterior area outside of the helix” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 55 is further allowable on this basis.

Claim 56

Claim 56 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that “the holder includes a pair of rotatable helixes” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 57

Claim 57 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that a “reference surface includes indicia thereon indicative of number of medical items in the holder” or “reading the indicia on the reference surface” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 58

Claim 58 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that a “cover is prevented from moving to the up position when the dispenser module is in the first position” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 58 is further allowable.

Claim 59

Claim 59 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest that “the holder includes a rotatable helix” or “extending a limiting member in the inside area of the helix, wherein the limiting member is operative to prevent a medical item from passing through the inside area of the helix absent rotation of the helix” in the manner

recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 60

Claim 60 further recites features that patentably distinguish the claimed invention over the applied art. Neither Kraft nor Pitel alone or in combination disclose or suggest “a further dispenser module in the interior area” and “dispensing a first medical item including a supporting card from the dispenser module” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further dispenser module” in the manner recited. Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 62

Claim 62 depends from claim 61. In the Action, claim 61 was not asserted to be anticipated by Kraft or Pitel, nor rejected as unpatentable over Kraft in view of Pitel. The lack of a rejection of claim 61 by either Kraft or Pitel, either alone or in combination, must be legally inferred that claim 61 is allowable over either Kraft or Pitel, either alone or in combination. It follows that claim 62, which includes the features and relationships of claim 61, is also allowable over Kraft in view of Pitel.

Nevertheless, Appellants wish to mention that neither Kraft nor Pitel alone or in combination disclose or suggest “dispensing a first medical item including a supporting card from the first dispenser module” or “dispensing a second medical item including a generally cylindrical liquid holding container from the second dispenser module” in the manner recited.

Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that claim 62 is further allowable for these reasons.

Claim 63

Claim 63 depends from claim 46 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the reference surface extends adjacent to the holder, and prior to step (c) comprising reading the indicia on the reference surface.”

The Action is silent with respect to the recited features of claim 63. Nevertheless, neither Kraft nor Pitel alone or in combination disclose “indicia” on a “reference surface”, nor reading indicia “indicative of the number of medical items in the holder” in the manner recited (claim 46). Nor do the applied references disclose “reading the indicia” prior to step (c). Thus, it is respectfully submitted that the claim is further allowable.

Claim 64

Claim 64 depends from claim 46 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the indicia includes indicia spaced in aligned, side by side relation on the reference surface, wherein the spaced indicia corresponds to different medical item sizes, and prior to step (c) further comprising determining the number of medical items held in the holder.”

The Action alleged that Kraft discloses determining the number of medical items held in the drawer at col. 5, lines 38-65 (page 10 of the Action). The Appellants disagree. Kraft does not disclose “indicia” on a “reference surface” as recited. It follows that Kraft does not disclose

that the “spaced indicia corresponds to different medical item sizes.” The referenced section of Kraft is not directed to the recited indicia features, nor determining the number of medical items held in the holder in the manner recited.

Pitel cannot overcome the deficiencies of Kraft as it does not disclose or suggest the recited features which are not found in Kraft. Pitel also does not disclose “indicia” on a “reference surface”, nor that “spaced indicia corresponds to different medical item sizes.”

Neither Kraft nor Pitel alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 65

Claim 65 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the module includes a latching lever, wherein the enclosure includes a latching pin, and further comprising engaging the latching lever with the latching pin to hold the module in the first position.”

The Action is silent with respect to the recited features of claim 65. The Action is silent as to what feature, if any, in Kraft or Pitel is asserted to correspond to the recited “latching lever” and “latching pin.” Nevertheless, neither Kraft nor Pitel disclose or suggest “engaging the latching lever with the latching pin to hold the module.” It follows that neither Higham nor Kraft alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that claim 65 is further allowable.

Claim 66

Claim 66 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “each module is movable in a direction toward the door from a respective first position, wherein each of the dispenser modules has a respective dispense location, wherein with the modules in the first position each dispense location is in different proximity in the direction relative to an adjacent module.”

In claim 66, with the modules in the first position each dispense location is in a different proximity in the movable direction toward the door relative to an adjacent module. That is, the dispense locations are in different proximity (e.g., relative to the door). For example, note Specification page 15, lines 4-10, and Figure 2.

The Action is silent with respect to the recited features of claim 66. The Action is silent as to what feature, if any, in Kraft or Pitel is asserted to correspond to the recited “modules”, “door”, “first position”, “dispense location”, and “different proximity.” Nevertheless, neither Kraft nor Pitel disclose or suggest that “with the modules in the first position each dispense location is in different proximity in the direction relative to an adjacent module.” It follows that neither Higham nor Kraft alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that claim 66 is further allowable.

Claim 67

Claim 67 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the dispenser

module includes a further holder.” The claim further recites “dispensing a first medical item including a supporting card from the holder” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further holder.”

The Action is silent with respect to the recited features of claim 67. The Action is silent as to what feature, if any, in Kraft or Pitel is asserted to correspond to the recited “holder”, “further holder”, “supporting card”, and “liquid holding container.” Nevertheless, neither Kraft nor Pitel disclose or suggest “dispensing a first medical item” and “dispensing a second medical item” in the manner recited. It follows that neither Higham nor Kraft alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that claim 67 is further allowable.

The Pending Claims Are Not Obvious in View of Pitel

In the Action claims 40, 43, 45, 52-53, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitel. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants’ claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Appellants’ invention. The features recited in Appellants’ claims patentably distinguish over the applied reference.

The Action admits that Pitel does not disclose that the item removed and placed within the dispenser is a medical item. The Action states that “The examiner takes official notice that the dispensing of medicaments such as aspirin and antacids is well known in the vending arts. It

would have been obvious for Pitel et al. to place a medicament within the helical dispensing tray because aspirin is a saleable and vendible product and its distribution is a service to consumers.”

The Appellants disagree. Pitel lacks many of the recited features. Pitel does not disclose or suggest the features and relationships that are specifically recited in the claims.

The rejected claims 40, 43, 45, 52, 53, and 56 all require the handling of “at least one medical item.” The Action has admitted that Pitel does not disclose that the item removed and placed within Pitel’s dispenser is a medical item. There is good reason why Pitel does not disclose or suggest use with a medical item. A closer reading of Pitel indicates that Pitel’s machine is specifically designed and sized to dispense articles such as “bagged snacks” (col. 1, lines 13-15; and col. 2, lines 64-66). As is well known, “bagged snacks” such as chips and pretzels are a common vending machine product. A common bag of chips is far removed from the specifically recited “medical item.” A common bag of chips is also far removed from the asserted “official notice” articles of aspirin and antacids. The Appellants assert that the dispensing of medical items is in a totally different field of art than that of vending bagged snacks. Pitel is non-analogous art.

Furthermore, a helix arrangement in a dispensing machine is specifically designed and sized for the specific product to be dispensed. Pitel requires the use of a pair of large helices (106, 108) for holding and dispensing the “bagged snacks.” In Pitel each individual bagged snack is supported between a pair of large helices. The requirement of dual large helices to support each individual bagged snack in Pitel indicates that Pitel’s “bagged snacks” are rather large. Even if it were somehow possible to dispense aspirin as alleged, the packaging required

for one or two aspirin would be rather small in comparison to Pitel's large "bagged snacks." Thus, it is respectfully submitted that packaged aspirin would not properly fit into or between Pitel's dual large helices. Furthermore, there is a large gap between Pitel's dual helices (106, 108). A package of aspirin would fall into the gap (or pass through the inside of the helices) and not be engagingly supported by the dual large helices. Thus, Pitel's dual helices would not be capable of engaging and advancing a package of aspirin. That is, one having ordinary skill in the art would recognize that a small package of aspirin would not be capable of being held and dispensed by Pitel's dual large helices. Additionally, there is a question of whether it would even be legal to place a non-fitting package of aspirin in the bagged snacks merchandising machine of Pitel.

Pitel's dual helix dispenser arrangement, as shown in Figure 2, is not capable of holding and dispensing aspirin as alleged. Nor has any evidence been presented that a small sized package of aspirin would require or even have the capability of being used with the dual large helices arrangement of Pitel. Nor would it have been obvious to one having ordinary skill in the art to even attempt to dispense aspirin using Pitel's dispenser. Pitel's dual helix dispenser arrangement is limited to dispensing "bagged snacks." Any other use of the dispenser of Pitel would require a major change in the structure of the disclosed dual helix dispenser arrangement. Any modification of Pitel's dual helix arrangement, if it were even somehow possible, would destroy the utility or advantage of Pitel and render the disclosed device of Pitel inoperable.

A reference teaching away from the recited invention does not support prima facie obviousness. It is improper to reconstruct a claimed invention from the disclosure of the

Appellants. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). As the combination of features asserted in the Action would destroy the utility and advantages of the cited Pitel reference, it is respectfully submitted that the rejection is improper and should be withdrawn.

The Action on page 16 refers to several references in an attempt to show dispensing of aspirin in vending machines. However, even if it were somehow possible to dispense aspirin as alleged, the packaging required for aspirin would not be capable of use with Pitel's dual large helices arrangement. Nor has any evidence been presented that a small sized package of aspirin would have the capability of being used with the dual large helices arrangement of Pitel. In other words, Pitel does not have the capability of dispensing packaged aspirin, but only large sized bagged snacks. Thus, it would not have been obvious to one having ordinary skill in the art to even attempt to dispense aspirin using Pitel's dispenser.

The vending machine of the cited Pearson reference is located in a security environment. The bagged snacks merchandising machine of Pitel would be located in an uncontrolled environment. Nor is there any evidence that the vending machines in the other cited references would be used in an uncontrolled environment like Pitel. Thus, it would not have been obvious to place a secure environment item into an insecure environment. Thus, it would not have been obvious to one having ordinary skill in the art to even attempt to dispense aspirin using Pitel's dispenser.

Pitel does not disclose or suggest the recited method. As nothing in the Pitel reference discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited reference with any other actual prior art, so as to produce Appellants' invention, it is respectfully submitted that claims 40, 43, 45, 52-53 and 56 are allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

Each of the claims subject to this rejection will further be discussed individually as presented herein.

Claim 40

Claim 40 is an independent claim which is specifically directed to a method performed in connection with a dispenser. The claim specifically recites that the dispenser module "includes a holder enabling holding of medical items" and "a dispenser mechanism, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder." Furthermore, the claim specifically recites "adding or removing at least one medical item from the holder."

Pitel does not disclose a dispenser module including a dispenser mechanism in the manner recited. Pitel does not disclose a dispenser mechanism selectively operable to dispense medical items from the holder. As admitted by the Office, Pitel does not disclose a medical item. As previously stated, Pitel's dual helix dispenser arrangement is limited to dispensing "bagged snacks." It clearly would not have been obvious to have placed aspirin in the dual helix arrangement of Pitel for the dispensing thereof.

Pitel does not disclose or suggest the recited method. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features so as to produce Appellants' invention, it is respectfully submitted that claim 40 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It follows that the claims which depend from claim 40 are likewise allowable.

Claim 43

Claim 43 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that "the dispenser further includes a path extending in the enclosure, wherein the path is in connection with a delivery area, whereby medical items are accessible to a user in the delivery area, wherein the dispenser mechanism is selectively operable to dispense medical items from the holder at a dispense location." As admitted by the Office, Pitel does not disclose a medical item. Also, Pitel does not disclose a "path" and "delivery area" and "dispense location" in the manner recited. Nor does Pitel disclose the recited relationship of the "path" and "delivery area" and "dispense location." Nor is there any teaching, suggestion, or motivation cited for combining features so as to produce Appellants' invention. Pitel does not disclose or suggest the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 45

Claim 45 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites "placing a medical item

in engagement with each of the helixes in the pair.” As admitted by the Office, Pitel does not disclose a medical item. It follows that Pitel does not disclose “placing a medical item in engagement with each of the helixes in the pair” in the manner recited. Nor is there any teaching, suggestion, or motivation cited for combining features so as to produce Appellants’ invention. Pitel does not disclose or suggest the recited method. Thus, it is respectfully submitted that claim 45 is further allowable.

Claim 52

Claim 52 is an independent claim. Claim 52 is specifically directed to a method performed in connection with a medical item dispenser. The claim specifically recites that the dispenser module “includes a holder enabling holding of medical items” and “a dispenser mechanism is selectively operable to dispense medical items from the holder.” Furthermore, claim 52 specifically recites “adding or removing at least one medical item from the holder.”

Pitel does not disclose a dispenser module including a dispenser mechanism as recited. Pitel does not disclose a dispenser mechanism selectively operable to dispense medical items from a holder. As admitted by the Office, Pitel does not disclose a medical item. As previously stated, Pitel’s dual helix dispenser arrangement is limited to dispensing “bagged snacks.” It would not have been obvious to have placed aspirin or indeed any medical item, in the dual helix arrangement of Pitel for the dispensing thereof. No evidence has been cited to support the assertion in the Action that there is any suggestion or teaching in the prior art to utilize features of Patet in dispensing medical items.

Pitel does not disclose or suggest the recited method. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features so as to produce Appellants' invention, it is respectfully submitted that claim 52 is allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

Claim 53

Claim 53 is an independent claim. Claim 53 is directed to a method performed in connection with a medical item dispenser apparatus. The claim specifically recites that the dispenser module includes a holder enabling "holding of medical items" and that "a dispenser mechanism is selectively operable to dispense medical items from the holder." Furthermore, the claim specifically recites "adding or removing at least one medical item from the holder."

Pitel does not disclose a dispenser module including a dispenser mechanism in the manner recited. Pitel does not disclose a dispenser mechanism selectively operable to dispense medical items from the holder. As admitted by the Office, Pitel does not disclose a medical item. As previously stated, Pitel's dual helix dispenser arrangement is limited to dispensing "bagged snacks." It would not have been obvious to have placed any medical item in the dual helix arrangement of Pitel for the dispensing thereof.

Pitel does not disclose or suggest the recited method. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features so as to produce Appellants' invention, it is respectfully submitted that claim 53 is allowable. Therefore, it is

respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome. It follows that the claims which depend from claim 53 are likewise allowable.

Claim 56

Claim 56 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “placing a medical item in engagement with each of the helixes in the pair.” As admitted by the Office, Pitel does not disclose a medical item. It follows that Pitel does not disclose “placing a medical item in engagement with each of the helixes in the pair” in the manner recited. Nor is there any teaching, suggestion, or motivation cited for combining features so as to produce Appellants’ invention. Pitel does not disclose or suggest the recited method. Thus, it is respectfully submitted that claim 56 is further allowable on this basis.

The Pending Claims Are Not Obvious Over Blechl in view of Kraft

In the Action claims 40, 42-44, 46, 48-51, 55, and 59-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Blechl in view of Kraft. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants’ claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Appellants’ invention. The features recited in Appellants’ claims patentably distinguish over the applied references.

The Office Action admits that Blechl does not disclose “engaging a helix within the holder a rotating mechanism”; “engaging a holder guide”; “placing a medical item in engagement with each of a pair of helixes”; and “extending a limiting member within the inside of the helix.” The Office Action asserts that Kraft discloses such features. The Office Action further asserts that it would have been obvious for Blechl to have such features.

The Appellants disagree. Blechl does not disclose or suggest the features and relationships that are specifically recited in the claims. Kraft lacks the capability of adding the recited features that are not found in Blechl. Neither Blechl nor Kraft alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method.

As nothing in the cited references disclose nor suggest the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants’ invention, it is respectfully submitted that these claims are allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

Claims 40, 42-43, 49-51, 60-61, and 63-66

Appellants’ arguments concerning the Blechl reference discussed above in support of the patentability of claims 40, 42-43, 49-51, 60-61, and 63-66 are incorporated by reference as if fully rewritten herein. Appellants’ arguments concerning the Kraft reference discussed above in support of the patentability of claims 40, 42-43, 46-47, and claims 40-49, 52-60, 62-67 are

incorporated by reference as if fully rewritten herein. Kraft does not disclose or suggest the features or relationships that are not found in Blechl.

As previously discussed, Blechl shows a cartridge (90) for insertion into a dispenser (60). Stacked medication containers (108) are contained in the interior storage space (102) of the cartridge (90). Upon actuation of the solenoid (68), the stepped portion (84) urges the medication container (108) resting on the dispensing platform (86) out the aperture (88) where gravity induces it to falls to the drawer (28).

As previously discussed, Blechl does not disclose a dispenser module being mounted in the manner recited. Blechl also does not disclose a “mounted” dispenser module including a “holder” and “a dispenser mechanism” in the manner recited. Blechl does not disclose moving a dispenser module, while mounted, including a “holder” and “a dispenser mechanism” in the manner recited. Kraft does not disclose or suggest the features or relationships that are not found in Blechl.

Kraft’s packaging system uses robotics (40) for manipulating a selected container (90, 130) to transfer medication units from the container directly to a package (314). In operation, the bulk medication container (130) is manipulated by the robotics (40) to place a single medication unit in a discharge holding area (152) of the container. The Action is silent as to what feature, if any, in Kraft constitutes the alleged helix. It is unclear whether Kraft’s helical ridge (136) is the alleged helix. Nevertheless, Kraft’s helical ridge (136) acts as a ramp for pills (134) in the container (130). The container is rotated to drop the medication unit into an opening (334) in a pocket (314) of a packaging system (38) where the unit is sealingly packaged.

Furthermore, the robotic packaging system of Kraft to sealingly package a medication unit, is contrary to the system of Blechl. Any attempt to incorporate a helix into the structure of Blechl is clearly hindsight reconstruction of Appellants' claimed invention, which is impermissible. The Action has not cited any teaching or motivation to include, or explained how, a helix could be incorporated into the system of Blechl. Furthermore, the Action has not explained why one skilled in the art would in any way be motivated to attempt to incorporate a helix into the system of Blechl. In Blechl, when the solenoid (68) is actuated the stepped portion (84) pushes the medication container (108) out the cartridge (90). A helix, even if it were somehow possible to install in Blechl, would serve no purpose. The Action has not explained how a helix could be incorporated into the cartridge (90) of Blechl. Thus, Blechl would not be improved with the addition of a helix. Clearly, one skilled in the art would not have attempted to incorporate a helix into the system of Blechl. Any alleged modification involving a helix, if it were somehow even possible, would appear to destroy the utility or advantage of Blechl and render the disclosed device of Blechl inoperable.

A reference teaching away from the recited invention does not support prima facie obviousness. It is also legally improper to reconstruct a claimed invention from the disclosure of the Appellants. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). It is respectfully asserted that the rejection is not appropriate.

Furthermore, even if it were somehow possible for Blechl to add the features of Kraft, Blechl would still lack the recited features and relationships of the dispenser module being movably mounted in the manner recited. Blechl would not disclose a “mounted” dispenser module including a “holder” and “a dispenser mechanism” in the manner specifically recited. Blechl would not disclose moving a dispenser module, while mounted, including a “holder” and “a dispenser mechanism” in the manner recited. Hence, Kraft does not disclose or suggest the recited features and relationships that are also not found in Blechl.

Additionally, in regard to claim 60, neither Blechl nor Kraft alone or in combination disclose or suggest “a further dispenser module” and dispensing “a supporting card” in the manner recited. Even if Kraft disclosed these features and relationships, it would not have been obvious to have included these features and relationships into a structure like that disclosed in Blechl. Neither Blechl nor Kraft alone or in combination, disclose or suggest “moving the mounted dispenser module from the first position to the second position” in the manner recited. Furthermore, even if it were somehow possible for Blechl to add the features of Kraft, Blechl would still lack the recited features and relationships of the dispenser module being movably mounted in the manner recited.

Additionally, in regard to claim 61, neither Blechl nor Kraft alone or in combination disclose or suggest a “guide arrangement” capable of supporting and guiding a dispenser module during dispenser module movement, in the manner recited. Furthermore, even if Kraft disclosed these features and relationships, it would not have been obvious to have included these features and relationships into Blechl. Neither Blechl nor Kraft alone or in combination disclose or

suggest a dispenser module movable while in supporting connection with an enclosure, in the manner recited. Furthermore, even if it were somehow possible for Blechl to add the teachings of Kraft, Blechl would still lack the recited features and relationships of the dispenser module being movable while in supporting connection with the enclosure as recited.

Neither Blechl nor Kraft alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in Appellants' claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' claimed invention, it is respectfully submitted that the claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

Features recited in other claims even further patentably distinguish over the applied art.

Claim 44

Claim 44 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied references. The claim specifically recites "the holder includes the helix." The claim further recites "engaging a holder guide in operative connection with the dispenser module, wherein a first portion of the holder guide is extended in an inside area within the helix and a second portion of the holder guide extends in an exterior area outside of the helix." Neither Blechl nor Kraft alone or in combination disclose or suggest that a "holder

includes the helix” and a “holder guide” in the manner recited. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, this referenced section of Kraft lacks the recited “helix” and “holder guide.” Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included Blechl with such features. Thus, it is respectfully submitted that claim 44 is further allowable.

Claim 46

Claim 46 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that a “reference surface includes indicia thereon indicative of the number of medical items in the holder.” The claim further recites “reading the indicia on the reference surface.” Neither Blechl nor Kraft alone or in combination disclose or suggest “indicia” on a “reference surface” in the manner recited. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that claim 46 is further allowable.

Claim 48

Claim 48 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the holder includes a rotatable helix.” The claim further recites “extending a limiting member in the inside area of the helix, wherein the limiting member is operative to prevent a medical item from passing through the inside area of the helix absent rotation of the helix.” Neither Blechl nor Kraft alone or in combination disclose or suggest a “rotatable helix” and a “limiting member” in

the manner recited. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, this referenced section of Kraft lacks the recited “rotatable helix” and “limiting member.” Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included Blechl with such features. Thus, it is respectfully submitted that claim 48 is further allowable.

Claim 55

Claim 55 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “the holder includes the helix.” The claim further recites “engaging a holder guide in operative connection with the dispenser module, wherein a first portion of the holder guide is extended in an inside area within the helix and a second portion of the holder guide extends in an exterior area outside of the helix.” Neither Blechl nor Kraft alone or in combination disclose or suggest that a “holder includes the helix” and a “holder guide” in the manner recited. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, this referenced section of Kraft lacks the recited “helix” and “holder guide.” Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included Blechl with such features. Thus, it is respectfully submitted that the claim is further allowable for these reasons.

Claim 59

Claim 59 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the holder includes a rotatable helix.” The claim further recites “extending a limiting member in the inside area of the helix, wherein the limiting member is operative to prevent a medical item from passing through the inside area of the helix absent rotation of the helix.” Neither Blechl nor Kraft alone or in combination disclose or suggest a “rotatable helix” and a “limiting member” in the manner recited. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method.

The Action references Kraft at col. 8, lines 25-67. However, again this referenced section of Kraft lacks the recited “rotatable helix” and “limiting member.” Nor does Kraft disclose such features in the manner recited. Nor would it have been obvious to have included Blechl with such features. Thus, it is respectfully submitted that claim 59 is further allowable.

Claim 62

Claim 62 depends from claim 61 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites “dispensing a first medical item including a supporting card from the first dispenser module.” The claim further recites “dispensing a second medical item including a generally cylindrical liquid holding container from the second dispenser module.” Neither Blechl nor Kraft alone or in combination disclose or suggest the “dispensing” of first and second medical items in the manner recited. Neither Blechl nor Kraft alone or in combination disclose or suggest the recited method. Neither

Blechl nor Kraft alone or in combination disclose or suggest “dispensing a first medical item including a supporting card from the first dispenser module” or “dispensing a second medical item including a generally cylindrical liquid holding container from the second dispenser module” in the manner recited. Thus, it is respectfully submitted that claim 62 is further allowable.

**The Pending Claims Are Not Obvious Over
Higham in view of Blechl**

In the Action claims 40-43, 46-47, 49-54, and 57-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Blechl. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants’ claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Appellants’ invention. The features recited in Appellants’ claims patentably distinguish over the applied references.

The Office Action admits that Higham does not disclose “closing the door”; a “cylindrical holding container contains a liquid”; “providing the holder with a plurality of items arranged in a stack”; “engaging a follower in engagement with the stack”; and “adding a plurality of medical items to the holder in side by side relation to a stack.” The Office Action asserts that Blechl discloses such features. The Office Action further asserts that it would have been obvious for Higham to have such features.

The Appellants disagree. Higham does not disclose or suggest the features and relationships that are specifically recited in the claims. Blechl lacks the capability of adding the recited features that are not found in Higham. Neither Higham nor Blechl alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. Neither Higham nor Blechl alone or in combination disclose or suggest the recited method.

As nothing in the cited references disclose nor suggest the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that these claims are allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

Claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66

Appellants' arguments concerning the Higham reference discussed above in support of the patentability of claims 40-43, 46-47, 49, 52-54, 57-58, 60, 62-63, and 66-67 are incorporated by reference as if fully rewritten herein. Blechl does not disclose or suggest the recited features or relationships that are not found in Higham. Appellants' arguments concerning the Blechl reference discussed above in support of the patentability of claims 40, 42-43, 49-51, 60-61, and 63-66 are incorporated by reference as if fully rewritten herein.

It is noted that claim 59 was not previously rejected by either the single reference of Higham or the single reference of Blechl. Therefore, it is respectfully submitted that the Action

by inference has admitted that neither Higham nor Blechl disclose or suggest the subject matter of claim 59. It is respectfully submitted that claim 59 is therefore allowable.

As previously discussed, in the operation of Higham, an item can be manually placed into or removed from a particular receptacle (36) of an open drawer (32) (col. 16, lines 37-45; col. 18, lines 43-47). Higham does not disclose or suggest a dispenser module including a “dispenser mechanism.” Higham does not disclose or suggest that a “dispenser mechanism” is “selectively operable to dispense medical items from the holder.” Higham’s manual removal of items specifically teaches away from using the recited “dispenser mechanism” to dispense medical items.

As previously discussed, Blechl shows a cartridge (90) for insertion into a dispenser (60). Stacked medication containers (108) are contained in the interior storage space (102) of the cartridge (90). Upon actuation of the solenoid (68), the stepped portion (84) urges the medication container (108) resting on the dispensing platform (86) out the aperture (88) where gravity induces it to fall to the drawer (28).

In Higham an item is manually placed or removed. Therefore, it would not have been obvious to modify Higham as alleged in the Action. In Higham a medical item is not capable of being dropped or falling by gravity to a lower location. In Higham a drawer is opened and an item is manually removed. In Higham there is no dispenser mechanism because the items are manually removed from the drawer. Hence, Higham has no need for the recited dispenser mechanism, and there is no possible motivation to include such a feature therein.

The solenoid system of Blechl is contrary to the manual system of Higham. Any assertion that one could incorporate a dispenser mechanism into Higham, is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is impermissible.

Furthermore, the Action has not cited any teaching or motivation in the applied art, or explained how, a dispenser mechanism could be incorporated into the manually operated drawer system of Higham. Furthermore, the Action has not explained or cited any motivation why one skilled in the art would ever attempt to incorporate a dispenser mechanism into the manually operated drawer system of Higham. When a drawer of Higham is opened, then the items are readily accessible. A dispenser mechanism, even if it were somehow possible to install in Higham, would serve no purpose. Thus, Higham would not be improved with the addition of a dispenser mechanism. Clearly, one skilled in the art would have no motivation to attempt to incorporate a dispenser mechanism into the manually operated drawer system of Higham. Any alleged modification involving a dispenser mechanism, if it were somehow even possible, would appear to destroy the utility or advantage of Higham and render the disclosed drawer system of Higham inoperable.

A reference teaching away from the recited invention does not support prima facie obviousness. It is improper to reconstruct the invention from the disclosure of the Appellants. An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). It is respectfully asserted that the rejection is improper for this reason.

In regard to Appellants' claims 52 and 53, Higham also lacks the recited path and delivery area. The arrangement of Higham's drawer system cannot reasonably be modified to include the recited features and relationships of a path and a delivery area. Therefore, even if Blechl disclosed these features and relationships, it would not have been obvious to have included these features and relationships in a structure like that of Higham.

Neither Higham nor Blechl alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims. Neither Higham nor Blechl alone or in combination disclose or suggest the recited method.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that the claims are allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

Features and relationships recited in Appellants' dependent claims further distinguish over the cited art.

Claim 50

Claim 50 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that "medical items are biased to move by gravitational force" and "providing a follower in engagement with the stack, wherein in the first position the follower provides additional biasing force on the stack." Neither Higham nor Blechl alone or in combination, disclose or suggest medical items "biased to move

by gravitational force” and a “follower in engagement with the stack” in the manner recited.

Neither Higham nor Blechl alone or in combination disclose or suggest the recited method.

Thus, it is respectfully submitted that the claim is further allowable.

Claim 51

Claim 51 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “medical items are biased to move by gravitational force” and a “movably positionable guide extending adjacent the stack” and a “generally cylindrical rotatably movable follower, including at least one annular groove, in operative engagement with the stack.” Neither Higham nor Blechl alone or in combination disclose or suggest medical items “biased to move by gravitational force” and a “movably positionable guide” and a “generally cylindrical rotatably movable follower” in the manner recited. Neither Higham nor Blechl alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that claim 51 is further allowable for these reasons.

Claim 59

Claim 59 depends from claim 53 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the holder includes a rotatable helix.” The claim further recites “extending a limiting member in the inside area of the helix, wherein the limiting member is operative to prevent a medical item from passing through the inside area of the helix absent rotation of the helix.” Neither Higham nor Blechl alone or in combination disclose or suggest a “rotatable helix” and a “limiting member” in

the manner recited. Neither Higham nor Blechl alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that claim 59 is further allowable.

Claim 61

Claim 61 is an independent method claim. The claim specifically recites first and second dispenser modules “in movably supporting connection with the enclosure” through first and second guide arrangements, wherein the guide arrangements are adapted to guide the dispenser modules “during movement.” Neither Higham nor Blechl alone or in combination disclose or suggest a “guide arrangement” capable of supporting and guiding a dispenser module during dispenser module movement, in the manner recited. Furthermore, even if Blechl disclosed these features and relationships, it would not have been obvious to have included these features and relationships into Higham. Inclusion of these features and relationships into Higham would destroy the utility or advantage of Higham and render the disclosed device of Higham inoperable.

Neither Higham nor Blechl alone or in combination disclose or suggest a dispenser module movable while in supporting connection with the enclosure. Furthermore, neither Higham nor Blechl alone or in combination disclose or suggest guide arrangements “interchangeably engageable to support either the first or second dispenser modules” in the manner recited. Furthermore, as previously discussed, Higham does not disclose or suggest dispenser modules that are “selectively operative to dispense medical items.” The above arguments against modifying Higham to be “selectively operative to dispense medical items” are incorporated by reference as if fully rewritten herein. Neither Higham nor Blechl alone or in combination disclose or suggest the recited method.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in Appellants' claim, and because there is no teaching, suggestion or motivation cited in the Action for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that claim 61 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection has been overcome.

Claim 64

Claim 64 depends from claim 46 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that "the indicia includes indicia spaced in aligned, side by side relation on the reference surface, wherein the spaced indicia corresponds to different medical item sizes, and prior to step (c) further comprising determining the number of medical items held in the holder."

The Action in paragraph number 16 is silent concerning the references with respect to the recited features of claim 64. The Action is silent as to what feature, if any, in Higham or Blechl is asserted to correspond to the recited features. The Action (paragraph number 6) previously alleged that Blechl discloses determining the number of medical items held in the drawer at col 8, lines 45-60. The Appellants disagree. The referenced section is directed to a brief description of the identification unit using passwords or IC cards, and an input unit (248). Blechl does not disclose "indicia" in the manner recited. Nor does Blechl disclose "determining the number of medical items held in the holder" in the manner recited.

Blechl cannot overcome the deficiencies of Higham as it does not disclose or suggest the recited features which are not found in Higham. Neither Higham nor Blechl disclose “indicia” on a “reference surface”, or that “spaced indicia corresponds to different medical item sizes.”

Neither Higham nor Blechl alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 65

Claim 65 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the module includes a latching lever, wherein the enclosure includes a latching pin, and further comprising engaging the latching lever with the latching pin to hold the module in the first position.”

The Action is silent with respect to the recited features of claim 65. The Action is silent as to what feature, if any, in Higham or Blechl is asserted to correspond to the recited “latching lever” and “latching pin.” The Action (paragraph number 6) previously alleged that Blechl discloses engaging the latching lever with the latching pin to hold the module in the first position at col 7, lines 47-58. The Appellants disagree. The referenced section is directed to a solenoid (68) and an actuator arm (82). Blechl does not hold a module in a first position by engaging a latching lever with a latching pin in the manner recited.

Blechl cannot overcome the deficiencies of Higham as it does not disclose or suggest the recited features which are not found in Higham. Neither Higham nor Blechl disclose “engaging the latching lever with the latching pin to hold the module in the first position.”

Neither Higham nor Blechl alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

**The Pending Claims Are Not Obvious Over
Higham in view of Gardner '294**

In the Action claims 63 and 65-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Gardner '294. These rejections are respectfully traversed.

The exact references applied are unknown and not of record. No Gardner '294 reference has been cited. The patent corresponding to Gardner '294 is unknown. Nor does it appear that a Gardner '294 reference even exists. Furthermore, there is a question as to whether the alleged Gardner '294 reference constitutes prior art. Appellants refuse to speculate which cited Gardner reference, if any, pertains to the applied Gardner '294. Appellants respectfully request that the rejections be withdrawn on the basis that they have not been provided the Gardner '294 reference nor has the relevance of the Gardner '294 reference been explained. Appellants also respectfully request that the rejections be withdrawn on the basis that there is no evidence of record that Gardner '294 is prior art or even exist.

Furthermore, the Office is reminded that any new citation (and/or applying) of a reference in an Examiner's Answer constitutes a new ground of rejection (MPEP § 1208.01). Therefore, the citation or application of any Gardner reference, including any Gardner '294 reference, will be viewed as constituting an impermissible new ground of rejection within the meaning of 37 CFR § 1.193(a)(2), which clearly prohibits the entry of a new ground of rejection in an

Examiner's Answer. Additionally, the attention of the Office is directed to MPEP 706.07(a) concerning premature Final rejections.

Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

**The Pending Claims Are Not Obvious Over
Higham in view of Halverson**

In the Action claims 63-64 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Higham in view of Halverson. These rejections are respectfully traversed.

Appellants respectfully request that the rejections be withdrawn on the basis that the Action is defective. The attempted rejection at numbered paragraph 18 mentions a Halverson reference but never officially applies the Halverson reference. The Action admits that Higham "does not disclose: determining the number of medical items held in the drawer." The Action then alleges that it "would have been obvious for Higham et al. '366 to determine the number of medical items held in the drawer" for reasons "as taught by Higham et al. '366." The Halverson reference is never applied. Furthermore, the Action provides a confusing and contradicting rejection attempt. Appellants cannot respond to such a defective Action, nor should they be forced to respond to such incomprehensible wording.

Furthermore, the exact references mentioned are unknown and not of record. No Halverson reference has been cited. Nor does it appear that a Halverson reference even exists. Furthermore, there is a question as to whether the alleged Halverson reference constitutes prior art. Appellants refuse to speculate what reference, if any, pertains to the Halverson reference.

Appellants respectfully request that the rejections be withdrawn on the basis that there is no evidence of record that Halverson is prior art or even exist.

Furthermore, there is no evidence of record that the Halverson reference corresponds to the cited Halvorson 4,847,764. To imply such would be pure speculation, of which the Appellants refuse to partake. Nor should Appellants be forced to take part in such speculation. Halverson is clearly not of record.

Furthermore, Halvorson 4,847,764, at col. 5, lines 35-65; and col. 3, lines 15-27, is not at all relevant to “determining the number of medical items held in the drawer” as alleged in the Halverson reference. Therefore, Halvorson 4,847,764 cannot constitute the Halverson reference, nor teach the recited features and relationships of claim 64. Furthermore, the col. 5, lines 35-65; and col. 3, lines 15-27 indicated sections in Halvorson 4,847,764 also do not teach nor suggest having “indicia spaced in aligned, side by side relation on the reference surface, wherein the spaced indicia corresponds to different medical item sizes.” Again, Halvorson 4,847,764 cannot constitute the Halverson reference, nor teach the recited features and relationships of claim 64.

Additionally, Halvorson 4,847,764, at col. 5, lines 35-65 indicates that the system does not even have a mechanical dispenser. This is in direct contrast to claim 40 (from which claims 63, 64, and 66 depend) which states that the dispenser module further includes a dispenser mechanism, and that the dispenser mechanism is selectively operable to dispense medical items from the holder.

The Action in numbered paragraph 18 is silent as to the recited features of claims 63 and 66. Appellants’ arguments concerning the Higham reference discussed above in support of the

patentability of claims 63 and 66 are incorporated by reference as if fully rewritten herein. Nor does Halvorson 4,847,764 disclose or suggest “reading the indicia on the reference surface” (claim 63) or that “with the modules in the first position each dispense location is in different proximity in the direction relative to an adjacent module” (claim 66). It follows that Halvorson 4,847,764 cannot constitute the Halverson reference, nor teach the recited features and relationships of claims 63 and 66.

Hence, the Halverson reference cannot provide the features and relationships that are not found in Higham. Nor would it have been obvious to one having ordinary skill in the art to have included alleged features of the Halverson reference with the unit of Higham. It is respectfully submitted that neither Higham nor Halverson alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claims are further allowable.

Furthermore, the Office is reminded that any new citation (and/or applying) of a reference in an Examiner’s Answer constitutes a new ground of rejection (MPEP § 1208.01). Therefore, the citation or application of any Halverson (or Halvorson) reference will be viewed as constituting an impermissible new ground of rejection within the meaning of 37 CFR § 1.193(a)(2), which clearly prohibits the entry of a new ground of rejection in an Examiner’s Answer. Additionally, the attention of the Office is directed to MPEP 706.07(a) concerning premature Final rejections.

**The Pending Claims Are Not Obvious Over
Williams '294 in view of Higham**

In the Action claims 63-67 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Williams in view of Higham. These rejections are respectfully traversed.

Appellants traverse these rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion or motivation cited so as to produce Appellants' invention. The features recited in Appellants' claims patentably distinguish over the applied references.

The Action admits that Williams does not disclose "reading indicia on the reference surface; dispensing a medical item including a support card from one of the modules" (claims 63 and 67). It is noted that claims 63-64 and 67 were not anticipated by Williams (numbered paragraph 5). Hence, by inference, the Action admits that Williams lacks the recited features of claims 63-64 and 67. The Action asserts that Higham discloses such missing features. The Action further asserts that it would have been obvious for Williams to have such missing features as taught by Higham. The Appellants disagree.

The Action is silent as to the recited features of claims 65-66. Appellants' arguments concerning the Williams reference discussed above in support of the patentability of claims 65-66 are incorporated by reference as if fully rewritten herein. Nor does Higham disclose or suggest "engaging the latching lever with the latching pin to hold the module in the first position" (claim 65) or that "with the modules in the first position each dispense location is in different proximity in the direction relative to an adjacent module" (claim 66). It follows that

Higham cannot overcome the deficiencies of Williams as it does not disclose or suggest the recited features which are not found in Williams.

Williams does not disclose or suggest the features and relationships that are specifically recited in the claims. Higham lacks the capability of adding the recited features that are not found in Williams. Neither Williams nor Higham alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. Neither Williams nor Higham alone or in combination disclose or suggest the recited method.

As nothing in the cited references disclose nor suggest the features and relationships that are specifically recited in the claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention, it is respectfully submitted that these claims are allowable. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections have been overcome.

Claim 63

Claim 63 depends from claim 46 and further recites features that patentably distinguish the claimed invention over the applied art. Claim 46, from which claim 63 depends, also recites that “the dispenser module includes a reference surface” and that “the reference surface includes indicia thereon indicative of the number of medical items held in the holder.” The claim 63 further specifically recites that “the reference surface extends adjacent to the holder, and prior to step (c) comprising reading the indicia on the reference surface.”

The Action (numbered paragraph 10) admits that Williams does not disclose “reading indicia on the reference surface (claim 46). It follows that Williams does not disclose or suggest

the recited features of claim 63, which depends on claim 46. The Action alleges that Higham discloses “reading the indicia on the reference surface” at col. 5, lines 3-18. The Appellants disagree. The cited section of Higham does not teach “reading the indicia on the reference surface” in the manner recited. Nor does the cited section teach that “the dispenser module includes a reference surface.” Nor does the cited section teach that “the reference surface includes indicia thereon indicative of the number of medical items held in the holder.” Nor does the cited section teach that “the reference surface extends adjacent to the holder.” Williams also lacks the recited features.

Neither Williams nor Higham alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 64

Claim 64 depends from claim 46 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the indicia includes indicia spaced in aligned, side by side relation on the reference surface, wherein the spaced indicia corresponds to different medical item sizes, and prior to step (c) further comprising determining the number of medical items held in the holder.”

The Action (numbered paragraph 10) admits that Williams does not disclose “reading indicia on the reference surface (claim 46). It follows that Williams does not disclose or suggest the recited features of claim 64, which depends on claim 46. As previously discussed (with regard to claim 63), neither Williams nor Higham alone or in combination disclose or suggest the

recited features of claim 46. It follows that neither Williams nor Higham alone or in combination disclose or suggest the recited features of claim 64, which depends on claim 46.

The Action alleged that Williams discloses determining the number of medical items held in the drawer at col. 9, lines 15-26. The Appellants disagree. The Action (numbered paragraph 10) admits that Williams does not disclose “reading indicia on the reference surface (claim 46). Williams does not disclose “indicia” on a “reference surface” as recited. It follows that Williams does not disclose that the “the indicia includes indicia spaced in aligned, side by side relation on the reference surface, wherein the spaced indicia corresponds to different medical item sizes.” The referenced section of Williams is not directed to the recited indicia features, nor to determining the number of medical items held in the holder in the manner recited.

Higham cannot overcome the deficiencies of Williams as it does not disclose or suggest the recited features which are not found in Williams. Higham also does not disclose “indicia” on a “reference surface”, nor “indicia spaced in aligned, side by side relation”, nor that “spaced indicia corresponds to different medical item sizes.”

Neither Williams nor Higham alone or in combination disclose the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Claim 67

Claim 67 depends from claim 40 and further recites features that patentably distinguish the claimed invention over the applied art. The claim specifically recites that “the dispenser module includes a further holder.” The claim further recites “dispensing a first medical item

including a supporting card from the holder” and “dispensing a second medical item including a generally cylindrical liquid holding container from the further holder.”

The Action (numbered paragraph 10) admits that Williams does not disclose “dispensing a medical item including a support card from one of the modules” (claim 67). The Action alleges that Higham discloses “dispensing a medical item including a support card from one of the modules” at col. 4, lines 53-58. The Appellants disagree. The cited section of Higham merely refers to a signal received from a switch. The cited section of Higham does not teach “dispensing a medical item including a support card from one of the modules” in the manner recited. Williams also lacks the recited features. It follows that neither Williams nor Higham alone or in combination disclose or suggest the recited method. Thus, it is respectfully submitted that the claim is further allowable.

Comments concerning identification of reference elements

The Action at pages 16-17 amazingly attempts to explain why the rejections do not have to be explained. The Action appears to indicate that only page numbers, columns, and lines have to be referenced in an applied reference, as opposed to reference numerals, regardless of clarity. The Action relies on MPEP 706.02(j).

The Appellants disagree. Even MPEP 706.02(j) indicates that the “relevant” teachings of the relied upon reference should be set forth. However, the Action on several occasions refers to numerous lines in the same column which results in no “relevant” teaching, nor can the “relevant” portion, if any, be ascertained.

Furthermore, it remains that the Office has not “fully and clearly stated” the rejection as is required by MPEP 707.07(d). Nor did the Office “properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply” in accordance with MPEP 706.02(j). Additionally, 37 C.F.R. § 1.104 (c) (2) regarding references requires that “the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained.” The Action is clearly defective. Appellants have been left with the burden of trying to properly respond to an unclear and defective Action.

The Action does not state in any way that is reasonably understandable by Appellants, where the specific features recited in Appellants’ claims are allegedly found in the cited art. Not one rejection based on prior art has specifically labeled all of the claimed features allegedly disclosed in the applied reference(s). Nor is there any citation to any alleged teaching, suggestion, or motivation to combine features of the prior art to produce the invention as claimed by Appellants. For this reason it is respectfully submitted that the Action fails to establish anticipation or a prima facie case of obviousness against any of Appellants’ claims and the rejections should be withdrawn.

The previous Responses respectfully asked the Office to clearly state on the record which specific (numbered) features in the references directly corresponded to the claimed dispenser, enclosure, dispenser module, holder, dispenser mechanism, and medical item. However, the Action has not addressed or answered all of Appellants’ request or traversals. Therefore, it is respectfully submitted that the Office is not in compliance with MPEP 707.07(f) which clearly

states “Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” For these additional reasons the rejections should be withdrawn.

Appellants are entitled to a clear presentation of any rejection. However, neither the previous Actions nor the present Action have presented a clear presentation of any rejection. Therefore, it is respectfully submitted that the Office is not in compliance with MPEP 707.07(d) which clearly states “where a claim is refused for any reason relating to the merits thereof it should be rejected and the ground of rejection fully and clearly stated.” Instead, the Office has nonsuccinctly referred to lengthy lines of text in the applied references without any specificity. The references themselves clearly identify therein all of their different elements with corresponding reference numerals. It is perplexing as to why the Office could not simply and fairly state on the record which reference numerals allegedly correspond to Appellants’ recited features. Appellants are entitled to know which exact reference numerals (corresponding to the reference features) that the Office considers to allegedly correspond to the recited features. Anything less is an attempt by the Office to clandestinely and unfairly reject without having to explain on the record the exact rejection. Furthermore, because the basis for the rejections have not been properly communicated, Appellants have not been given a fair opportunity to properly reply.

The Action's failure to specifically indicate the presence of the recited claim features in the references constituted Agency Action under the Administrative Procedures Act admitting that the references do not meet the recited claim features. For these additional reasons the rejections should be withdrawn.

Comments concerning extraneous language in the rejections

Additionally, Appellants take exception to the mention of other non-rejected claims in the body of rejections.

For example, claims 52 and 53, do not form any part of the 35 U.S.C. § 102 rejection by Blechl yet they are mentioned in the body of rejection.

For example, claims 52, 53, 57, 58, and 67 do not form any part of the 35 U.S.C. § 102 rejection by Higham yet they are mentioned in the body of rejection.

For example, claims 52, 53, 57, 58, 63, 64, 66, and 67 do not form any part of the 35 U.S.C. § 102 rejection by Kraft yet they are mentioned in the body of rejection.

For example, claim 45 does not form any part of the 35 U.S.C. § 103 rejection by Higham in view of Kraft yet it is mentioned in the body of rejection.

For example, claim 42 does not form any part of the 35 U.S.C. § 103 rejection by Pitel yet it is mentioned in the body of rejection.

For example, claims 45 and 56 do not form any part of the 35 U.S.C. § 103 rejection by Blechl in view of Kraft yet they are mentioned in the body of rejection.

The extraneous language in the body of the rejections obfuscates the issues. The extraneous language in the body of the rejections raises the question of which exact claims are being rejected. Thus, because the Action is unclear, Appellants are forced to speculate as to which exact claims are being rejected. Clearly the Action is defective. For these additional reasons the rejections should be withdrawn.

Furthermore, the issue of extraneous language in the rejections was previously brought to the attention of the Office in the response filed September 7, 2000 (at page 87). However, as evidenced by the still present extraneous language, the response was either never read or the Office refused to remove the extraneous language.

Comments concerning the Higham reference

The Action on page 17, for the first time, alleges that Higham discloses certain recited elements. However, it is unclear as to which specific claim rejections these alleged Higham elements pertain. Nor have the alleged Higham elements been applied in any specific claim rejection based on Higham (prior to Action page 17). That is, they have not been referenced in any body of a specific rejection. Nor have these alleged elements in Higham been explained with respect to any claim rejection based on Higham (prior to Action page 17). Thus, these allegations cannot be a part of any listed Higham rejection. Appellants refuse to speculate as to which claim rejections, if any, that these Higham allegations pertain. Since the Higham allegations on page 17 have not been presented and applied in the body of any specific claim rejection, then they should not be considered.

Furthermore, Appellants are not pleased that the Office waited until after the Appellants were under final rejection to specifically allege on Action page 17 some of the recited features in the Higham reference (i.e., to attempt to explain a rejection). The Appellants' previous Responses respectfully asked the Office to clearly state on the record which specific (numbered) features in the Higham reference directly corresponded to the claimed dispenser, enclosure, dispenser module, holder, dispenser mechanism, and medical item. For example, note page 15 of the Response filed May 9, 2000, and pages 85-86 of the Response filed September 7, 2000. However, the previous Actions did not address or answer Appellants' requests. By not previously answering Appellants' requests the Office was not in compliance with MPEP 707.07(f). That is, after two prior Office Actions involving the Higham reference, the Office first attempts to explain their reasoning of the Higham applicability only after final rejection. Thus, not only did the lack of explanation of the Higham reference place an undue burden on Appellants, but because the Office had full knowledge of their view of the Higham applicability but only revealed it after prosecution was closed (after final rejection), the Appellants were also treated unfairly.

The additional comments concerning Higham constitute a new grounds of rejection

Appellants' prior arguments against the Higham rejections were based on the Office's previous interpretation of the Higham reference as indicated and applied in the previous Office Actions (and the current body of Higham rejections). Now the Office has expanded and newly added to the grounds of rejection involving the Higham reference without being necessitated by

amendment, and has prevented Appellants from the due process of amending by closing prosecution. Therefore, it is respectfully submitted that this new interpretation and application of the Higham reference by the Office clearly constitutes a new grounds of rejection. Thus, it is respectfully requested that this new grounds of rejection be treated as such by the Office.

Comments on defective Action

The comments presented herein provide only some examples of the unclear, confusing, unsupported, and incongruent rejections (and Action) that have been presented to Appellants without regard to the statutes, rules, Office procedures, or teachings of the references. The Action is defective. For these reasons it is respectfully requested that the rejections be withdrawn.

CONCLUSION

As explained above, each of the pending claims specifically recite features, relationships, or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellant's invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'R. Jocke', is written over a horizontal line.

Ralph E. Jocke

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